LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
MAY 23 1962
JOHN F. DAVIS, CLERK

In the
Supreme Court of the United States

OCTOBER TERM, 1962

No. [redacted] 138

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
PETITIONER,

v.

ALLEN B. DUMONT LABORATORIES, INC.,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

ROBERT H. RINES
DAVID RINES
No. Ten Post Office Square
Boston 9, Massachusetts
THOMAS COOCH
120 Montvale Road
Weston 93, Massachusetts
Attorneys for the Petitioner

Blanchard Printing Company, Boston, Mass. — Law Printers

SUBJECT INDEX

	Page
Opinions Below	2
Jurisdiction	2
Question Presented	3
Statute Involved	3
Statement of the Case	3
Introduction	3
Discussion of Question I	7
Reasons for Granting the Writ	8
Appendix:	
A—Opinion of the Third Circuit	11
B—Opinion of the Fifth Circuit	25

List of Citations

Aro Mfg. Co. v. *Convertible Top Replacement Co., Inc.*, 365 U.S. 336	7
Electric Cable Co. v. *Edison Co.*, 292 U.S. 69	2
Leeds and Catlin Company v. *Victor Talking Machine Company*, 213 U.S. 301	9
Pierce v. *Aeronautical Communications Equipment, Inc.*, 255 F.2d 458	2, 6, 7
Pierce v. *American Communications Co. Inc.*, 208 F.2d 763, cert. denied 347 U.S. 970, 348 U.S. 851; 280 F.2d 278, cert. denied 364 U.S. 902	5, 6
Pierce v. *Allen B. DuMont Laboratories, Inc.*, 166 F. Supp. 332; 178 F. Supp. 84; 297 F.2d 323	6, 7, 9
Pierce v. *Hewlett-Packard Co.*, 220 F.2d 531, cert. denied 350 U.S. 833	5
Sola Electric Company v. *Jefferson Electric Company*, 317 U.S. 173	2
United States v. *American Bell Telephone Company*, 167 U.S. 224	9

In the
Supreme Court of the United States

OCTOBER TERM, 1962

No.

HELEN RUSSELL PIERCE, Executrix of the
Last Will and Testament of
GEORGE WASHINGTON PIERCE, Deceased,
PETITIONER,

v.

ALLEN B. DUMONT LABORATORIES, INC.,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Helen Russell Pierce, executrix of the estate of the late Professor George Washington Pierce, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit, entered in the above-entitled action on November 29, 1961.

A certified transcript of the record in the above case

(hereinafter referred to as "Tr."), including the proceedings in the said Court of Appeals, is furnished herewith.

Opinions Below

The opinion of the Court of Appeals for the Third Circuit is reported at 297 F.2d 323 (1961) and appears as Appendix A to this petition, and at Tr. 115b.

A conflicting opinion of the Court of Appeals for the Fifth Circuit, *Pierce* v. *Aeronautical Communications Equipment, Inc.*, (C.A. 5, 1958) is reported at 255 F.2d 458 and appears as Appendix B to this petition.

Jurisdiction

The judgment of the Court of Appeals for the Third Circuit was entered on November 29, 1961. An order extending the time for filing this petition for certiorari to and including May 25, 1962, was issued by this Honorable Court on March 9, 1962 (Associate Justice William J. Brennan, Jr.). The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254(1).

Specifically, this petition involves a case where the Court of Appeals for the Third Circuit has rendered a decision in conflict with a decision of the Court of Appeals for the Fifth Circuit with regard to the *same* patent,[1]—a decision that constitutes *brand new law* as to which no authority is even cited, and which is diametrically opposite to all prior decisions of the Supreme Court.

---

[1] Rule 19(b) of this Court re jurisdiction in conflicting decisions of courts of appeals on same matter. See, also, *Electric Cable Co.* v. *Edison Co.*, 292 U.S. 69, 70; and *Sola Electric Company* v. *Jefferson Electric Company*, 317 U.S. 173, 174-175.

Question Presented

I.

Whether the Court of Appeals for the Third Circuit is correct in holding, as a new proposition of law, that it constitutes an illegal "extension" of patent "monopoly" for an inventor to issue his application for a novel element [2] as a patent, *after* the issuance of his copending application for a combination [3] using such novel elements?

(This Court may wish to postpone action on this petition pending the outcome of a further decision on this same issue by the Court of Appeals for the Fifth Circuit; the argument in which cause has been set for hearing June 26, 1962.)

Statute Involved

The pertinent statute is the New Patent Act of 1952, enacted pursuant to the Constitutional provision, Article I, Section 8, relating to the grant of patents for invention.

Statement of the Case

Introduction

The late Professor George Washington Pierce, of Harvard University, is recognized throughout the world as the inventor of the said Pierce oscillator—an electronic circuit operating under the control of a quartz piezo-electric

---

[2] The so-called Pierce oscillator—an electronic oscillation circuit that produces electrical oscillations of constant frequency, in world-wide use not only in radio, but in scientific instruments, in sound generators, calibrators, and many other applications. (Patent 2,113,642)

[3] A cooperative radio transmitter-and-receiver combination having a first Pierce oscillator at the transmitter cooperating with a second Pierce oscillator at the receiver (Claim 2—Patent 1,789,496)

crystal for producing electrical oscillations of very constant frequency.

The three Courts of Appeals for the First, Third and Fifth Circuits are agreed that this Pierce oscillator constituted a patentable invention.

The Pierce oscillator is employed, as an oscillating element, in many different combinations of electrical equipment. It is not restricted to use in radio [2].

Each of the Courts of Appeals of the First, Third and Fifth Circuits, agrees that patent 2,133,642, here in issue, covers the Pierce oscillator circuit *per se* and thus, for purposes of discussion, may be referred to as the basic novel *element* patent.

Each of the said Courts of Appeals agrees that earlier-issued Pierce patent 1,789,496 involves only *combination* claims for a combined cooperative radio transmitter-and-receiver system; and that in only *one* claim thereof (claim 2), and not in either of the other two claims, was the Pierce oscillator even specified as an element of the combination. And at that, this one claim called for *two*, cooperative Pierce oscillators—one at the transmitter and one at the receiver—and *not* for a single Pierce oscillator alone.

Each of the said Courts of Appeals further agrees that at one time Dr. Pierce tried to issue his Pierce oscillator element claims in the same patent as the cooperative transmitter-and-receiver combination claims, but that the Patent Office refused to permit this to be done.

Each of the said Courts of Appeals additionally agrees that the patent examiner requested Dr. Pierce's attorney to file a separate divisional application for the cooperative transmitter-and-receiver combination.

The Courts of Appeals for the First and Fifth Circuits have held this to be a *formal* requirement for division; but the Court of Appeals for the Third Circuit, following the

decision of the District Court for the District of Delaware, has held this to be an *informal* requirement for division expressed at an interview with the examiner, and made of record in a contemporaneous paper filed by the attorney.[4]

Each of the said Courts of Appeals, however, agrees that the divisional application for the transmitter-and-receiver *combination* issued as a patent, *first;* and that the basic Pierce oscillator patent for the Pierce oscillator *element* alone, was involved in interferences and issued later.

This *combination* patent, involving in one claim thereof, the cooperative use of two Pierce oscillator elements, thus issued before the Pierce oscillator *element* patent, and Question 1, *supra*, is thus raised; namely, in trying to enforce the basic Pierce oscillator element patent, is Dr. Pierce now unlawfully extending any patent "monopoly"?

The District Court for the District of Massachusetts, in the initial case involving this patent held,[5] 111 F. Supp. 181, 189

> "Pierce's two patents are *not* for the same invention . . . Once he has succeeded in geting patent protection for his basic invention *he should be entitled to enjoy that protection for the full period allowed by the law.* (citations)" (emphasis supplied).

The Court of Appeals for the First Circuit reversed, however, holding, 208 F.2d 763, 769

---

[4] Paper No. 10, October 22, 1927 (PX37 and DX3, page 61, 62): "The applicant is preparing divisional applications . . . in accordance with the requirements of the Office, both formally expressed in the Office letters and informally expressed during the said interview."

[5] At these earlier and incomplete stages of this litigation, this Court declined certiorari, *Pierce* v. *American Communications Co., Inc.*, (C.A. 1, 1953) 208 F. 2d 763, cert. denied 347 U.S. 970, 348 U.S. 851; (C.A. 1, 1960) 280 F. 2d 278, cert. denied 364 U.S. 902; *Pierce* v. *Hewlett Packard Co.*, (C.A. 1, 1955) 220 F. 2d 531, cert. denied 350 U.S. 833.

> "it is not necessary . . . to decide whether or not the two patents may possibly cover separate inventions . . . *We cannot now extend that monopoly under the mantle of patent No. 2,133,642.*"

The Court of Appeals for the First Circuit then reversed its ground with regard to extension of monoply and predicated its holding, rather, on "double patenting", 280 F.2d 278.[5]

The Court of Appeals for the Fifth Circuit disagreed with the Court of Appeals for the First Circuit, 255 F.2d 458 (Appendix B, p. 34, 35)

> "plaintiff did make a significant contribution with the Pierce oscillator, he is entitled to the patent on it *alone*, to prevent its use without his consent *in any combination* and for the full 17 years." (emphasis added)

The District Court for the District of Delaware at first sided with the Court of Appeals for the Fifth Circuit against the Court of Appeals for the First Circuit, 166 F. Supp. 332, 335-6[6]

> "*In the face of the contradictory results arrived at by the First and Fifth Circuit Courts* . . . I am impressed . . . that Prof. Pierce . . . is entitled to a patent on it (the Pierce oscillator) carrying with it all the protection to which an inventor is entitled for the *full seventeen years* of the life of the patent." (parenthesis and emphasis supplied)

The District Court for the District of Delaware then re-

[6] *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 1958, D.C. Del. 166 F. Supp. 332

versed itself and ruled with the Court of Appeals for the First Circuit as to "double patenting", and against the Court of Appeals for the Fifth Circuit, in the decision here at issue [7] (Tr. 6a, 15a):

> "This is at variance with the opinion of the Fifth Circuit Court of Appeals in Pierce v. Aeronautical Communications Equipment Co., 255 F.2d 458".

In the decision here in issue as to which this petition is sought, the Court of Appeals for the Third Circuit, in the light of the Supreme Court's recent holdings with regard to the relation between combination and element patents in *Aro Mfg. Co.* v. *Convertible Top Replacement Co., Inc.*, 1961, 365 U.S. 336, *declined to follow* the "double patenting" holding of its own District Court (Appendix A, p. 23).

Instead, the Court of Appeals for the Third Circuit asserted the doctrine of illegal extension of "monopoly", *without the citation of a single case to support this new proposition of law:*

> "We decide merely that patent '496 protected Pierce in the use of the Pierce oscillator in radio transmitting and receiving systems. We have already pointed out that it is the extension of this monopoly beyond its proper seventeen year term which invalidates the generic patent."

Discussion of Question I

Every week the Patent Office is granting hundreds of patents for new combinations of elements as well as for new elements alone, and in no particular order of issuance.

---

[7] *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 1959, D.C. Del. 178 F. Supp. 84

There are in force well over a half a million patents for new combinations of elements, as well as for new elements by themselves, already granted without regard to order of issuance.

The conflicting and inconsistent reasoning in the decisions in *three* circuits with regard to the Pierce oscillator patent here in issue, has thrown into utter confusion the status of these element patents in the light of the combination patents that have issued involving the use of the elements.

If the answer to Question I, above, is in the affirmative, as held by the Court of Appeals for the Third Circuit, then present Patent Office practice must be promptly radically revised; and patentees should accordingly promptly be apprised by the Supreme Court that certain of their patents are thus invalid.

If, on the other hand, the answer to Question I is in the negative, as held in the first partial decision relating to the same Pierce patent here involved by the Court of Appeals for the Fifth Circuit, then the Court of Appeals for the Third Circuit should be over-ruled by the Supreme Court so that the status of combination and element patents is no longer in the serious state of doubt and confusion that has resulted from the present Third Circuit decision.

Reasons for Granting the Writ

The status of all related combination and element patents, previously granted and presently being granted each week *without regard to their order of issuance*, has been thrown into serious doubt.

Who now knows what is and is not an improper extension of a patent?

Who now knows whether the order in which related combination and element patents issue is or is not of any sig-

nificance, and thus whether present Patent Office practice is *spawning myriads of invalid patents every week?*

The Court of Appeals for the Third Circuit, indeed, has itself indicated the necessity for review by the Supreme Court in its statement (Appendix A, p. 24) that this is a

> *"case involving difficult and doubtful points of law".*

This Court should promptly resolve the conflict between the Courts of Appeals for the Third and Fifth Circuits as to whether one may or may not obtain a later-issuing element patent after first obtaining an earlier patent for a combination employing such elements.

This Court should make plain, moreover, whether the Court of Appeals for the Third Circuit is correct in its understanding that "protection" cannot legally extend more than seventeen years, or whether prior decisions of the Supreme Court to the contrary are correct.

The Supreme Court has previously pointed out, for example, in *United States* v. *American Bell Telephone Company*, 1896, 167 U.S. 224, 247,

> "It will not do to say that, because Congress has declared that seventeen years is the life of a patent, seventeen years is the limit of the possible monopoly; * * * Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent."

This holding of the Court of Appeals for the Third Circuit is also contrary to the holding of the Supreme Court in *Leeds and Catlin Company* v. *Victor Talking Machine Company*, 213 U.S. 301, 319, that a patent for a combination and a patent for an element of the combination are different inventions, and that, consequently,

"Each invention is given the full period of seventeen years, which the statute prescribes for it."

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the Court of Appeals for the Third Circuit, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Court of Appeals for the Third Circuit be reversed; and that your petitioner be granted such other and further relief in the premises as may be just and proper.

Respectfully submitted,

ROBERT H. RINES
DAVID RINES
No. Ten Post Office Square
Boston 9, Massachusetts
THOMAS COOCH
120 Montvale Road
Weston 93, Massachusetts
Attorneys for the Petitioner

Appendix A

UNITED STATES COURT OF APPEALS
THIRD CIRCUIT

No. 13279.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of George Washington Pierce, Deceased,
APPELLANT,
v.
ALLEN B. DU MONT LABORATORIES, INC.

Argued Oct. 7, 1960 and May 22, 1961.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

Before BIGGS, *Chief Judge*, and HASTIE and FORMAN, *Circuit Judges*.

OPINION OF THE COURT.

(Filed November 29, 1961)

By HASTIE, *Circuit Judge*.

This appeal has been taken from a judgment of a district court in a patent infringement suit. The trial court held that claims 3, 26, 40, 51, 52, 54-56, and 61-68 of Pierce Patent No. 2,133,642 were invalid for double patenting over the earlier Pierce Patent No. 1,789,496.[1] D.Del.1959, 178 F.Supp. 84. For convenience the numbers of the two patents will be designated throughout this opinion as "'642" and "'496".

Patent '496 was issued in 1931 on an application filed in

[1] While the pleadings and the trial covered alleged infringement of several related patents, appellant has elected to base this appeal solely upon controverted questions as to the validity and the infringement of '642, which is the basic patent.

1928. It expired some six years before the 1954 filing of the present suit. Patent '642 was issued in 1938 after a considerable history which will be detailed later. That patent expired after the filing, but before the trial, of this case.

I

A preliminary question must be decided because the inventor George Washington Pierce, who filed this complaint, died before trial. Over the objection of the defendant, the court ordered that Pierce's widow and executrix, Helen Russell Pierce, be substituted as plaintiff. D.Del.1957, 154 F.Supp. 368. Although the defendant prevailed on the merits below, it urges as appellee in this court that we need not and should not reach the merits of the appeal, but rather should rule that the cause of action was extinguished by the death of the original plaintiff. This jurisdictional problem is our first concern.

Appellee's argument, that a cause of action for damages for infringement of a patent, which has expired since that infringement, does not survive the death of the owner of the patent, proceeds in two steps. First, it is pointed out that property in patents exists solely by virtue of federal statutory law and that the incidents of that property are refined and determined by the patent statutes. This is the principle of Crown Die & Tool Co. v. Nye Tool & Machine Works, 1923, 261 U.S. 24, 43 S.Ct. 254, 67 L.Ed. 516. Second, it is argued that, since causes of action for patent infringement thus depend upon federal statutes for existence and definition, they must lapse with the death of the patent owner, unless a federal statute affirmatively provides for their survival. This is a non sequitur. Certainly, no such conclusion is required by the Crown Die case, which did not involve the problem of the effect of the death of a patentee upon the statutory right to collect damages for past infringement. Moreover, it is a necessary, if not articulated,

premise of appellee's argument that some rule or principle of law outside of the patent statutes cuts off the cause of action when the patent owner dies. This must be the case simply because the patent law itself gives no guidance on this question. Whether the conclusion shall be that the right survives or that it does not, the controlling rule must be derived from a source other than the patent statutes.

In practice, federal courts, required to decide whether various federal statutory causes of action survive, have been explicit and consistent in holding that, where the right creating statute says nothing about survival, resort to common law conceptions as evolved in English and American decisions is appropriate. Van Beeck v. Sabine Towing Co., 1937, 300 U.S. 342, 57 S.Ct. 452, 81 L.Ed. 685; Schreiber v. Sharpless, 1884, 110 U.S. 76, 3 S.Ct. 423, 28 L.Ed. 65; Sullivan v. Associated Billposters & Distributors, 2d Cir., 1925, 6 F.2d 1000, 42 A.L.R. 503; Walsh v. New York, N. H. & H. R. R., C.C.D.Mass.1909, 173 F. 494, aff'd, 1912, 223 U.S. 1, 32 S.Ct. 169, 56 L.Ed. 327. Such inquiry discloses a common law rule of survival, originally applied to a limited group of damage claims for tortious invasion of property rights, but subsequently broadened toward sanctioning the survival of claims for redress of injuries to monetary interest generally. Van Beeck v. Sabine Towing Co., supra; Kirk v. Commissioner of Internal Revenue, 1st Cir., 1950, 179 F.2d 619, 15 A.L.R.2d 1031.

This approach has resulted in rulings that various federal statutory causes survive without statutory stipulation. The question of survival arises frequently in civil suits for injury to business caused by violations of the antitrust laws. These claims are held to survive. Barnes Coal Corp. v. Retail Coal Merchants Ass'n, 4th Cir., 1942, 128 F.2d 645; Moore v. Backus, 7th Cir., 78 F.2d 571, 101 A.L.R. 379, cert. denied, 1935, 296 U.S. 640, 56 S.Ct. 173, 80 L.Ed. 455; Sullivan v. Associated Billposters & Distributors, supra. In

a different area, the Supreme Court has held, and this court has recognized, that a dependent's right under the Merchant Marine Act, 46 U.S.C.A. § 688 and the Federal Employers' Liability Act, 45 U.S.C.A. § 51 et seq. to recover the pecuniary loss he has suffered through the death of the decedent, survives the death of the dependent and may be exercised by his administrator. Van Beeck v. Sabine Towing Co., supra; Wade v. Regala, 3d Cir., 1959, 270 F.2d 280, 284.[2]

Of course, the principle "that a patent is property, protected against appropriation * * * by individuals * * * has long been settled." See Hartford-Empire Co. v. United States, 1945, 323 U.S. 386, 415, 65 S.Ct. 373, 387, 89 L.Ed. 322. For purposes of survival we can see no reason for putting actions for damage suffered through patent infringement on a different basis from the above cited invasions of other property rights.

As a separate point appellee argues that the often stated rule that penal claims do not survive is applicable here because the patent statute under which this suit is brought authorizes the recovery of treble damages. However, this argument has not prevailed in the above mentioned situation of treble damage suits under the antitrust laws. Barnes Coal Co. v. Retail Coal Merchants Ass'n, supra. Moreover, the statute involved in the present case lends itself to the separation of the basic compensatory award of actual damages from any permissible additional award of punitive

---

[2] More recently, one court of appeals has extended the Van Beeck result to allow a survivor's administrator to recover for an employee's pain and suffering under Section 9 of the Federal Employers' Liability Act. Dellaripa v. New York, N. H. & H. R.R., 2d Cir., 1958, 257 F.2d 733, 72 Harv.L.Rev. 558 (1959). In so doing, however, the court completely rejected the traditional distinction between "personal" and "property" rights as concerns survival. 257 F.2d at 735. We are not asked to go this far in the present case. See also Baumet v. United States, 2d Cir., 1949, 177 F.2d 806, cert. denied, 1950, 339 U.S. 923, 70 S.Ct. 611, 94 L.Ed. 1346.

character. The statute provides primarily for the award of "damages adequate to compensate for the infringement". 35 U.S.C. § 284, 1958. Thereafter, it authorizes "the court * * * [to] increase the damages up to three times the amount found or assessed". Therefore, even assuming that the severable provision for the discretionary multiplication of damages is penal, this affords no justification for cutting off the basic right to compensatory recovery. In the posture of this case no more than that need be decided.

Appellee makes a final argument that the claim for damages for past infringement does not survive because the law does not permit a patentee to assign such a claim apart from the patent itself. However, any considerations of policy which oppose the separation of a cause of action for past infringement from the right of present enjoyment of a patent cease to be relevant after the expiration of the patent has eliminated the right of present enjoyment. It is not surprising, therefore, that such authority as there is on the point supports the assignability of a past infringement claim after the patent has expired. Ross v. City of Fort Wayne, 7th Cir., 1894, 63 F. 466; Tompkins v. St. Regis Paper Co., D.C.N.D.N.Y. 1915, 226 F. 744, aff'd 2d Cir., 1916, 236 F. 221; May v. Saginaw County, C.C.E. D, Mich. 1887, 32 F. 629. Thus, it does not help appellee to borrow the rules of assignability as guides to the determination of survival.

Finally, on this entire question of survival no policy consideration has been suggested which would make it unfair to allow a claim for past infringement to be exercised by an administrator in the interest of the estate of a deceased patentee. It is just as undesirable to permit a patent infringer to retain the fruits of his wrongdoing in this situation as it is when the patentee himself is suing. Compare Dellaripa v. New York, N. H. & H. R. R., 2d Cir., 1958,

257 F.2d 733. Thus broad policy and technical analysis both indicate that appellee's contentions are not sound.

We are the more confident of the correctness of our view of this matter because the same result has been reached in carefully reasoned opinions by two of the three district courts which have fully analyzed the problem. Armstrong v. Allen B. Du Mont Labs., Inc., D. Del. 1955, 137 F.Supp. 659; Armstrong v. Emerson Radio & Phonograph Corp., S.D.N.Y. 1955, 132 F.Supp. 176. Contra Van Choate v. General Electric Co., D.C.D. Mass. 1917, 245 F. 120.

II

We come now to the merits of the controversy. Was the trial court correct in ruling patent '642 invalid for double patenting over the patentee's earlier '496? Both patents embody Pierce's invention of a new method and apparatus utilized in electrical circuits to produce and sustain oscillations at more constant frequency than had theretofore been achievable, particularly in high frequency systems. Because inability to control frequency variations had hampered the development of high frequency radio communication, the effective incorporation of Pierce's invention in both transmitting and receiving circuits was a major achievement in an important field. Pierce's essential teaching was that the introduction of a two electrode piezoelectric crystal of his devising into a vacuum tube circuit as a mechanical vibrator accomplished the desired stabilization. This novel and unquestionably inventive device and procedure for frequency control in oscillating electrical systems will hereafter be called the Pierce oscillator. The patent infringement alleged in this case is the use of this device by appellee in two types of television transmitters, in a mobile transmitter-receiver and in a time calibrator.

As early as 1924 Pierce filed a patent application containing many claims, both broad and narrow, covering the

Pierce oscillator in various combinations and asserting many beneficial effects. In 1928, after the elimination of certain claims which are not relevant here, the still pending original application contained all of the claims which were later to be divided and granted separately in patent '496 and patent '642. Pierce then eliminated three of the remaining claims from this pending original application and incorporated them in a divisional application upon which patent '496 issued in January 1931. For present purposes it is sufficient that this first issued patent claimed a radio transmitting and receiving system wherein the new stabilizing Pierce oscillator was joined in effective combination with other elements of such a system which, admittedly, were old and familiar in the art.

More than a year before patent '496 issued, the patent office had allowed what remained of the original application, including a generic claim to the Pierce oscillator as a means of frequency stabilization in any oscillating system. Indeed, it is clear and not disputed that as early as September 1929 Pierce could have obtained a comprehensive patent, claiming and protecting his oscillator generically, merely by paying a final fee on his approved original application. However, he elected not to pay this fee within the prescribed time. Instead, he allowed this opportunity to pass and later made a timely renewal of his application as the patent law authorizes. Counsel representing the Pierce interests now tells us that Pierce thus voluntarily delayed the issuance of a patent on his generic claim because of his desire to have an interference declared with a rival inventor, one Miller, whose claims conflicted with those of Pierce and were a cloud on his title to the new oscillator. In any event, Pierce renewed his basic application in 1930. An interference was declared in 1932 and the dispute with Miller was finally adjudicated in 1938 when this court ruled that Miller had derived his alleged inven-

tion from Pierce. Miller v. National Broadcasting Co., 3 Cir., 1935, 79 F.2d 657. Thereafter, in October 1938 a patent on the remaining claims of the original Pierce application, including the generic claim to the Pierce oscillator, was issued as patent '642. The infringement alleged in the present action occurred less than seventeen years after the issuance of this patent but after the expiration of the earlier patent '496.

Both parties to the present litigation recognize that under our patent system, based as it is upon statutory monopoly limited to a seventeen year period, it is an inherent principle that an inventor is not entitled to the issuance of two patents at different times for the same invention. However, in administering the rule against double patenting it is not always clear what constitutes a single invention.

Perhaps the most frequently cited statement of the rule appears in Miller v. Eagle Mfg. Co., 1894, 151 U.S. 186, 198, 14 S.Ct. 310, 315, 38 L.Ed. 121, where the Supreme Court said:

> "* * * no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a broader claim, more generical in its character, than the specific claims, contained in the prior patent, is also void; but that where the second patent covers matter described in the prior patent, essentially distinct and separable from the invention covered thereby, and claims made thereunder, its validity may be sustained.
>
> "In the last class of cases it must distinctly appear that the invention covered by the later patent was a separate invention, distinctly different and independent from that covered by the first patent; in other

> words, it must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent. If the case comes within the first or second of the above classes, the second patent is absolutely void."

Since Miller v. Eagle, courts have repeatedly ruled that an inventor's separate applications embodying the same inventive concept afford proper bases for the issuance of separate patents at different times only if one of them also embodies an additional inventive concept not present in the other. In other words, the difference between the claims of the two applications must itself be inventive. Weatherhead Co. v. Drillmaster Supply Co., 7th Cir., 1955, 227 F.2d 98; In re Woodsome, 1926, 56 App.D.C. 138, 10 F.2d 1003; Palmer Pneumatic Tire Co. v. Lozier, 6th Cir., 1898, 90 F. 732; In re Copeman, 1943, 135 F.2d 349, 30 CCPA 962; In re Laughlin, 1931, 48 F.2d 921, 18 CCPA 1230; Ex parte Gump, Pat. Off. Bd.App., 1948, 83 U.S.P.Q. 351. But cf. Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co., 2d Cir., 1927, 22 F.2d 259.

A typical application of this rule appears in American Bell Tel. Co. v. National Tel. Mfg. Co., C.C.D.Mass.1901, 109 F. 976, aff'd on other grounds, 1st Cir., 1903, 119 F. 893. The inventor's original patent application contained a generic claim for a novel telephone transmitter. But before final action on this generic claim, a patent was granted on a co-pending divisional application for a telephonic communication system incorporating this transmitter as its only novel element. In holding that a second patent could not lawfully be granted on the transmitter itself, the court analyzed the situation in a way that is helpful here.

"[The first patent] confers a monopoly of the transmitter with a restriction or limitation. The patent in suit confers a monopoly without restriction. The patents are nevertheless both for the 'same invention,' both in a legal and a practical sense. [The earlier patent] * * * presents the familiar case of an inventor taking a patent with an unnecessary limitation. The commissioner has exhausted his power, and cannot afterwards give him a general grant for all uses. The argument that the use of the transmitter or of the receiver alone would not infringe * * * [the earlier patent] is immaterial. It does not prove that the claim is for a * * * [different] invention, but merely that the claim does not cover all the uses which might have been covered, had the patentee not chosen to take a claim for a restricted use. That the two patents are not coextensive does not affect the application of the rule against double patenting." 109 F. at 1033.

Similarly, in the present case the Pierce oscillator is the only new and inventive feature of the combination patent '496. Moreover, the Pierce oscillator performs no different function and achieves no significantly different result in this combination than when used in any other circuit. Thus, invention inheres not in any unusual characteristic or result of the particular combination, but merely in the normal functioning of a novel component. Yet, patent '642 was issued thereafter for this very component in its general adaptation to its normal role. The controlling doctrine, elaborated in the excerpt we have quoted from the American Communication case is stated more tersely in Palmer Pneumatic Tire Co. v. Lozier, supra: "One cannot extract an essential element of his invention from a former patent, without which the former patent would not have been granted, and make it the subject of a subsequent patent."

90 F. at 744. This line of reasoning has already led the Court of Appeals for the First Circuit to find the patent in suit invalid. Pierce v. Hewlett-Packard Co., 220 F.2d 531, cert. denied, 1955, 350 U.S. 833, 76 S.Ct. 69, 100 L.Ed. 744. But cf. Pierce v. Aeronautical Communications Equipment, Inc., 5th Cir., 1958, 255 F.2d 458.

But even if the foregoing analysis is persuasive in most cases where successive patents have reflected but one inventive concept, it is argued that the second patent should be granted where circumstances beyond the applicant's control have resulted in patent office approval of a divisional application before administrative action has been completed on an earlier or simultaneously filed basic application. The point is made that such administrative delay, for which the applicant has no responsibility and over which he has no control, should not deprive him of the second partially overlapping generic claim needed to give him full protection for his invention pursuant to his initial application, even though the more restricted monopoly first granted to him is thereby extended somewhat beyond its orginal term. This argument is said to be reinforced in this case by the additional fact that Pierce eliminated the claims for a radio transmitting and receiving system from his original application and incorporated them in a divisional application only after a patent examiner had made it clear that he was unwilling to approve a patent on the original application unless there should be such division.

Where such protection for a longer time that the patent law contemplates has in fact resulted solely from administrative delay in the patent office, it may well be that a balancing of the equities will justify the allowance of both patents. Fehr v. Activated Sludge, Inc., 7th Cir., 1936, 84 F.2d 948; see Union Typewriter Co. v. L. C. Smith & Bros., C.C.W.D.Pa. 1909, 173 F. 288, 297, aff'd, 3d Cir.,

1910, 181 F. 966. Of course the patentee's equitable position is strengthened where it appears as an additional fact that the patent office itself has required a division that resulted in harmful delay.[3] In most such cases the harm of double patenting will be slight because administrative delay in allowing the earlier application is not likely to be long enough to extend the original monopoly much beyond its proper seventeen year term.

But this is not the present case. Here, the inventor, by merely paying his final fee could have obtained his generic patent more than a year before he actually obtained the narrower patent '496. He made a considered election to postpone his acquisition of the broader monopoly until he was sure that its exploitation would not be hampered by conflicting claims of a rival inventor. Yet, somewhat later, when the divisional application, which certainly was no less embarrassed than the generic one by the Miller claims, won patent office approval he paid his final fee promptly and accepted the patent. This, therefore, is not a case where administrative action prevented the inventor from having his more comprehensive application patented first, but rather where the choice has been the inventor's, dictated by his own judgment of possible economic advantage. We think these circumstances are not such as to justify an

---

[3] The court below found that "at no time did the Examiner actually order a division". Rather, "seeing that he would either have to divide or suffer a final rejection by the Examiner and appeal therefrom, [the appellant] voluntarily divided". Whether a formal administrative order requiring a division must be appealed and judicially affirmed before the second of the resultant two patents is protected against a claim of double patenting and consequent invalidity, is a matter of dispute in the cases. With National Tube Co. v. Steel & Tubes, Inc., 3d Cir., 1937, 90 F.2d 52, and In re Cady, 1935, 77 F.2d 106, 22 CCPA 1190, contrast Remington Rand Business Service, Inc. v. Acme Card System Co., 4th Cir., 71 F.2d 628, cert. denied, 1934, 293, U.S. 622, 55 S.Ct. 236, 79 LEd. 710, and In re Woodsome, supra. See also In re McKee, 1935, 79 F.2d 905, 23 CCPA 717.

exception to the general rule and policy against double patenting. Cf. Miller v. Eagle Mfg. Co., supra.

One additional observation seems pertinent. It was the view of the court below that the combination patent '496 gave the patentee some measure of protection for the Pierce oscillator as such, since the oscillator was the only inventive feature of the claimed combination. Were this point essential to our decision it would be necessary to decide whether this view can be squared with recent decisions of the Supreme Court limiting the protection which a patent claiming only a particular combination can give to a constituent element of that combination. Aro Mfg. Co. v. Convertible Top Replacement Co., 1961, 365 U.S. 336, 81 S.Ct. 599, 5 L.Ed.2d 592; Mercoid Corp. v. Minneapolis-Honeywell Regulator Co., 1944, 320 U.S. 690, 64 S.Ct. 278, 88 L.Ed. 396; Mercoid Corp. v. Mid-Continent Investment Co., 1944, 320 U.S. 661, 64 S.Ct. 268, 88 L.Ed. 376. We decide merely that patent '496 protected Pierce in the use of the Pierce oscillator in radio transmitting and receiving systems. We have already pointed out that it is the extension of this monopoly beyond its proper seventeen year term which invalidates the generic patent.

One possibility of avoiding this unwarranted extension of monopoly has been suggested; namely, that the later generic patent may be held valid except that it shall not be deemed to protect such adaptations of the invention to radio transmitting and receiving as have already been covered by the earlier combination patent. A rational patent system might include such a refinement. Indeed, such a reconciliation of partially overlapping successive patents is made where an inventive difference is found to exist between their claims. E. g., Washburn & Moen Mfg. Co. v. Norwood (The Barbed Wire Patent), 1892, 143 U.S. 275, 12 S. Ct. 450, 36 L.Ed. 161. But, where there is no inventive difference between the claims of the two patents the partial

validation of the more comprehensive claims of the second overlapping patent seems unwarranted. Ex. parte Gump, supra. Rather, the patentee who has justification for supplementing his patented claims without embodying any new invention is left to the established reissue procedure for enlarging his monopoly without extending its term. See Union Typewriter Co. v. L. C. Smith Bros. Typewriter Co., 3d Cir., 1910, 181 F. 966, 969

Finally, appellee complains that the court below denied its motion for attorneys' fees under 35 U.S.C. § 285. In denying this motion the court quite properly found "that no bad faith on the part of the plaintiff has been shown". This has been a hard and fairly fought case involving difficult and doubtful points of law. It certainly discloses no such imposition or unfairness as the statute contemplates in its limited authorization of counsel fees. Cf. Hardinge Co., Inc. v. Jones & Laughlin Steel Corp., 3d Cir., 1960, 275 F.2d 37.

The judgment will be affirmed.

Appendix B

UNITED STATES COURT OF APPEALS
FIFTH CIRCUIT

No. 16830.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of George Washington Pierce, Deceased,
APPELLANT,
v.
AERONAUTICAL COMMUNICATIONS EQUIPMENT, INC.,
APPELLEE.

Before RIVES, TUTTLE and JONES, *Circuit Judges*

May 12, 1958.

TUTTLE, *Circuit Judge.*

This is an appeal from an order of the United States District Court for the Southern District of Florida granting defendant's motion for summary judgment. The defendant is charged with infringing five patents issued to the former, now deceased, plaintiff, George Washington Pierce. The five patents in the suit comprise Nos. 2,133,642, 2,133,643, 2,133,645, 2,133,646, and 2,133,648, all issued on October 18, 1938.[1] It is alleged that the defendant a Florida corporation, is infringing plaintiff's exclusive rights under these patents by manufacturing, using and selling electrical and electromechanical vibrator systems and apparatus, including the Pierce oscillator. The summary judgment has the effect of ruling that all of the patents in issue are invalid.

[1] The complaint also alleged infringement of a sixth patent, No. 2,266,070, but plaintiff withdrew it at an earlier stage in the litigation.

The primary, but not the sole, importance of the patents involved is in the field of radio broadcasting where a need had existed for controlling the frequency of oscillating electrical circuits. Radio communication is transmitted by carrier waves which are generated from the transmitter by an alternating current of electricity flowing in and out of an antenna, composed of wires suspended in the air. Radio waves are produced when the current oscillates at a high frequency. Since communication between a sender and a receiver is possible only when both are tuned to the same frequency, it is highly desirable that the frequency of the waves sent out from a transmitter remain constant.

The problem of attaining constant frequency had existed prior to 1912 when deForrest discovered that the thermionic vacuum tube or triode could be used to generate electric oscillations. This invention provided a feasible method, and since 1912 many experts in the field searched for improved means of controlling the frequency of electric systems. The principal fault with the deForrest tube was that after the circuit had been in operation a while the elements in the circuit became heated and an undesirable amount of variation in the frequency resulted.

It was finally through the use of piezoelectric crystals that the solution came. These crystals were first noted in 1880 by Jacques and Pierre Curie. Because of their component substances, direct current when applied to them will cause the surfaces of the crystal to contract or expand. When mechanical forces are applied to contract or expand the crystal, electrical potentials of opposite sign are built up on the opposing surfaces of the crystal. Little had been accomplished in using the piezoelectric crystals in the radio field until Professor Walter G. Cady, of Wesleyan University began experimenting with the possibilities, and his work eventually attracted the attention of Pierce.

Professor Pierce discovered a means whereby the cir-

cuit could oscillate without employing any inductive coils or condensers and this could be accomplished at a remarkably constant frequency. In the Pierce oscillator, as it has come to be called in the field, a piezoelectric crystal is positioned in the input circuit, between the cathode and the grid or control electrode, or between the grid or control electrode and the anode. In the first named system the tunable resonant output circuit, consisting of the inductance coil and the condenser, is tuned to a higher frequency than the natural frequency of the crystal. Then when the system is in operation it will produce oscillations at a constant frequency determined by the natural frequency of the crystal. An important characteristic of the Pierce oscillator is that with the aid of a piezoelectric crystal having only two electrodes, it is not necessary to rely upon mechanical feed-back through a four-electrode crystal to obtain oscillations of very high frequencies such as are needed in radio transmission, and this is accomplished with the assurance that the oscillator will not oscillate except at that specific high frequency.

The Pierce oscillator is in wide use throughout the world through the licensing agreements granted by Professor Pierce, and it is acknowledged that Pierce has made a significant contribution to the field of electrical circuits and radio transmission.

At the time of inventing the Pierce oscillator, Pierce invented a number of subsidiary electrical systems for which, by application of February 25, 1924, he endeavored to obtain a single patent covering them all. Since this application included not only general claims for the use of a piezoelectric crystal to control the frequency of an oscillating system but also specific claims for the combination of a radio transmitter and receiver in which such crystals could be used, the Patent Office held that more than one invention was described in the application and

ordered a division. In compliance with this order Pierce filed a number of additional applications and several of the resulting patents are involved in this suit. One of the additional applications matured, however, on January 20, 1931, into patent No. 1,789,496, and this patent expired in 1948, before the defendant began the infringement acts complained of in this suit.

Patent No. 1,789,496, consisting of three claims, is for a radio transmitting and receiving system in combination, having a means of keeping the oscillations of both the transmitter and receiver at the same constant frequency. Claim 1 specifically mentions the use of a piezoelectric body for controlling the frequency of these oscillations and that would seem to allow the piezoelectric-crystal-controlled oscillators shown in the Cady patent No. 1,472,583 to be used as an element in the combined transmitting and receiving system. Claim 2 specifies the use of an electro-mechanical vibrator having two electric terminals in a single vacuum tube circuit, which circuit oscillates at a frequency widely independent of the other elements in the circuit. It thus apparently specifies the Pierce oscillator. Claim 3 is much broader in that it calls for any kind of prior art electro-mechanical vibrator to control the frequency.

Action on Pierce's other applications, which resulted from the order for a division was delayed because of requests for a fuller explanation of the properties of piezoelectric crystals and the failure to pay on time the required final fee. On April 20, 1930, the Patent Office issued a patent to John M. Miller covering claims 51, 52, 54, 56 and 61 to 68 inclusive of Pierce's now patent No. 2,133,642. Litigation resulted in the holding that Pierce and not Miller was the inventor of the Pierce oscillator represented by the above claims. Miller v. National Broadcasting Com-

pany, Inc., 3 Cir., 79 F.2d 657; Miller v. Pierce, 97 F.2d 141, 25 C.C.P.A., Patents, 1195. Thereafter, on October 18, 1938, the Pierce patent, No. 2,133,642, and the other four patents involved in this suit were issued.

After the expiration in 1948 of the protection provided by Patent No. 1,789,496 various business concerns began to produce electrical vibrator systems, which Pierce believed infringed his six patents, which had not, by that time expired. He entered nine suits in several different circuits against various defendants.[2]

In the instant suit the plaintiff moved for a preliminary injunction to restrain the defendant from infringing the thirteen claims of patent No. 2,133,642 which were in issue in Pierce's litigation with Miller. That motion was denied and the denial was affirmed by this Court on the grounds that there was no showing of irreparable injury or abuse of discretion. 223 F.2d 410.

Since the District Court in the issue now before us based its summary judgment upon the "reasoning" of two First Circuit Court of Appeals cases instituted by the plaintiff against others than the present defendant, it becomes necessary at the outset to consider those opinions. In American Communications Co. v. Pierce, 1 Cir., 208 F.2d 763, both parties moved for summary judgment only on claims 51, 52, 54, 55, 56 and 61 to 68, inclusive, of the basic patent, No. 2,133,642. The district court 111 F. Supp. 181, holding that the claims were valid and infringed, granted plaintiff's motion and denied defendant's motion. The Court of Appeals reversed, holding that generic patent No. 2,133,642 for an electrical system relating particularly to the use of a piezoelectric crystal for producing at a constant

[2] The eighth of those suits was Pierce v. Allen B. Du Mont Laboratories, D.C. Del., 156 F. Supp. 237. Footnote 1 therein lists the nine cases.

frequency the oscillation of such system, when read specifically on the combined transmitting and receiving systems discloses no invention distinct and separate from that of patent No. 1,789,496 and that it would not extend the plaintiff's monopoly under the mantle of patent No. 2,133,642. The Court reasoned that neither claim 1 nor claim 3 of patent No. 1,789,496, revealed any distinctive contribution to the art of frequency stabilization or radio systems; and when analyzing claim 2 with a typical claim of patent No. 2,133,642, claim 67, clause by clause, it concluded that the only significant difference indicated in the claims is the use to which the piezoelectric crystal may be put. Claim 2 of patent No. 1,789,496 narrows the operation of the crystal to the combined transmitting and receiving system whereas claim 67 of patent No. 2,133,642 more broadly states its use in any generating system. But as the radio system described by Pierce was held not to be novel in and of itself, the only inventions were the position and the method in which the two-electrode piezoelectric crystal was used in the combination.

In the other case, the district court in Pierce v. Hewlett-Packard Company, 125 F. Supp. 329, granted defendant's motion for summary judgment, declaring the above claims of patent No. 2,133,642 invalid. The Court of Appeals affirmed on the authority of the American Communications Co. case to the effect that there was double patenting in that the plaintiff's patents Nos. 1,789,496 and 2,133,642 made only one distinctive contribution, which was the novel use of the two electrode piezoelectric crystal in a single vacuum tube circuit. 1 Cir., 220 F.2d 631.

[1] As the present appeal involves all five of Pierce's patents it is apparent that there is more in issue in this suit than in the First Circuit cases and in the prior appeal in this case. The claims of patent No. 2,133,642, other than

the thirteen litigated by the Court of Appeals of the First Circuit and the claims of the remaining four patents were not in issue or even considered by the First Circuit[3] in the cases upon which the district court in this case based its holdings. As the plaintiff is entitled to a considered opinion by the district court, she should be given an opportunity to present evidence including expert testimony, documents and exhibits to prove that the nonlitigated claims involve improvements or entirely different inventions from those involved in the thirteen claims of patent No. 2,133,642. This is entirely apart from the question of correctness of the trial court's judgment as to these thirteen claims.

[2] It does appear that plaintiff, in order to secure a ruling that could have decided the validity issue in her favor, selected for the prior suits and the preliminary injunction motion in this suit certain claims of patent No. 2,133,642, and termed it the "basic patent," but this decision should not preclude her from having the courts pass upon the validity of the other patents. Since there is a different defendant in this suit no issue of res judicata or collateral estoppel can arise to bind the plaintiff by any holding or stipulation in the prior suits.

[3-5] We ought not dismiss too quickly the fact that the Patent Office Examiner ordered a division of plaintiff's original application on the ground that there were separate and distinct inventions and that six patents were granted from plaintiff's applications. As was stated in In re Cady, 77 F.2d 106, 109, 22 C.C.P.A., Patents, 1190, decisions of

---

[3] It is noted that upon remand of the American Communications Company case, Judge Ford, in an unpublished opinion, Civil Action No. 51,526-F, January 31, 1958, considered the other claims and patents and held that all but patent No. 2,133,643 were void for double patenting. He, therefore, granted summary judgment for the defendant in respect to all patents except that one. The issue as to that one remains to be tried. This opinion could not have been a basis for the district court's decision which was entered May 2, 1957.

the examiner "should not be lightly overruled."[4] The burden of establishing invalidity of a patent rests upon the party asserting it and that burden is heavy. 35 U.S.C.A. § 282; Mumm v. Jacob E. Decker & Sons, 301 U.S. 168, 57 S.Ct. 675, 81 L.Ed. 983. From the status of the record regarding these patents it does not appear that these patents received the consideration from the court to which they were entitled, and the case was not, therefore, ripe for summary judgment.

In regard to claims 51, 52, 54, 55, 56 and 61 to 68 inclusive of patent No. 2,133,642, we find that the reasoning of the American Communications case and the reasoning of the Hewlett-Packard case, even if valid concerning double patenting, when placed together, do not necessarily preclude plaintiff's success in this case. It is still open to the plaintiff to contend and prove that the 1,789,496 patent was invalid for want of invention and that the 2,133,642 patent is not, therefore, void for double patenting. See O'Reilly v. Morse, 15 How. 62, 14 L.Ed. 601; Thomson-Houston Electric Co. v. Ohio Brass Co., 6 Cir., 80 F. 712. If the combination patent, No. 1,789,496 was not a valid invention, it was void *ab initio;* and having no existence there could be no monopoly relating to it and it could not be used as a predicate for double patenting. Since this case must be remanded for trial upon the merits of the above patents, plaintiff in all fairness should be allowed an opportunity to present this proof.

[6] In explaining its American Communications de-

[4] Although the Patent Act of 1952, especially section 121 of Title 35 was not in effect when the Patent Office ordered the division in this case, it does embody the policy of protecting the patentee in certain respects, including the benefit of the earlier filing date, when a division is ordered by the Office. The report from the House of Representatives Committee on The Judiciary, H.R.Rep. No. 1923, 82nd Congress, 2nd Session, 1952 states that "neither of the resulting patents can be held invalid over the other merely because of their being divided in several patents."

cision, the First Circuit Court of Appeals said in Hewlett-Packard that "the plaintiff in patents Nos. 1,789,496 and 2,133,642 made only one distinctive contribution." Further it stated:

> "The plaintiff received patent No. 1,789,496 only because of his contribution of a device which stabilized the frequency of oscillations of an electric circuit. Without this device the patent would not have been granted. The plaintiff cannot extract this essential element and make it the subject of a subsequent patent. Palmer Pneumatic Tire Co. v. Lozier, supra, 90 F. [732] at page 744, see Application of Horneman, 1952, 194 F.2d 108, 39 C.C.P.A., Patents, 809. The Pierce oscillator, the subject of patent No. 2,133,642 rather than the production of a constant beat, is the essential distinguishing feature of combination patent No. 1,789,496. See Application of Coleman, 1951, 189 F.2d 976, 38 C.C.P.A., Patents, 1156." [220 F.2d 532.]

This language suggests that patent No. 1,789,496 was not valid at all in that it was issued for a combination radio transmitting and receiving system with claims both using and not using Pierce oscillators. It can be argued that if the combination, the idea of the patent, lacks invention, the entire patent is invalid. In the situation, as in patent No. 1,789,496, in which the patentee relies upon the combination as a whole, rather than one element of it, the court should judge the combination itself as a whole. See Rieke Metal Products Corp. v. Barrel Fitting & Seal Corp., 7 Cir., 100 F.2d 259; 40 Am. Jur., Patents § 163. Where the patent is for a combination and no claim is made specifically for any one of the elements, it is conclusively presumed that the elements are old in the art or are not patentable. Richards v. Chase Elevator Co., 159 U.S. 477, 16 S.Ct. 53,

40 L.Ed. 225; Harris v. Ladd, 8 Cir., 34 F.2d 761; City of St. Louis v. Prendergast, 8 Cir., 29 F.2d 188. The district court, therefore, must ascertain whether claims No. 1 and No. 3 are too broad, and if the decision is that they describe radio systems already in the public domain, then it must proceed to determine whether the Pierce oscillator is claimed sufficiently in claim No. 2 to provide the combination with an element of novelty. If upon this analysis, invention is found lacking, patent No. 1,789,496 is invalid and there can be no double patenting.

[7] Even if the First Circuit cases have analyzed the situation correctly, they do not proceed to the point of considering the position of a patentee who has a patent on a combination invention which includes in it a patentable element. The plaintiff in this case may be able to prove that the Pierce oscillator itself is not sufficiently described in claim 2 of patent No. 1,789,496 to provide Pierce with sufficient protection. If someone had used the Pierce oscillator in a system other than the radio system described in No. 1,789,496, the plaintiff would have had difficulties, perhaps insurmountable, in proving that he was afforded protection under No. 1,789,496. A patent on a combination is a patent on the functioning whole, not on the separate parts and the fact that an unpatented element of a combination may distinguish the invention does not draw to it the privileges of a patent. Mercoid Corporation v. Mid-Continent Investment Co., 320 U.S. 661, 64 S. Ct. 268, 88 L.Ed. 376; Mercoid Corporation v. Minneapolis-Honeywell Regulator Co., 320 U.S. 680, 64 S.Ct. 278, 88 L.Ed. 396; Rowell v. Lindsay, 113 U.S. 97, 5 S.Ct. 507, 28 L.Ed. 906.

The reasoning of the above First Circuit opinions is, moreover, opposed to the basis of the division order and places the inventor in a perplexing dilemma. He must divide his claims into separate applications for separate patents to comply with the Patent Office's requirements,

but when he does this he faces the prospect of losing part of his protection, if, as in this case, the patents are issued at different times, and the double patenting argument is used against him. If, as appears to be undisputed, the plaintiff did make a significant contribution with the Pierce oscillator, he is entitled to a patent on it alone to prevent its use without his consent in any combination and for the full 17 years. If the oscillator is not specifically claimed as such in patent No. 1,789,496 that patent should stand or fall as a combination patent and have no bearing on the oscillator patent No. 2,133,642; otherwise by obeying the Patent Office's order the plaintiff is denied a portion of the protection to which he is entitled.

Since it was the Patent Office which required the division that led to the two separate patents, plaintiff does not come under the rule of Palmer Pneumatic Tire Co. v. Lozier, 6 Cir., 90 F. 732, prohibiting one from extracting an essential element of his invention from a former patent without which that patent would not have been granted and taking it for the subject of a new patent. Plaintiff originally had presented all of his claims in 1924 and because of the separation ruling and the litigation with Miller he was not awarded a final patent on the oscillator itself until 1939.[5] He is not then in the position of one who tries to extend his coverage by taking the element from the combination for a later and separate patent. Plaintiff should now be allowed to prove that the oscillator is not specifically claimed in patent No. 1,789,496, and that at most it was only protected by that patent to the extent it was used in the combination described therein.

The judgment of the District Court is reversed and the case is remanded for further proceedings not inconsistent with this opinion.

---

[5] This is one of the evils to which section 121, Title 35 of the Patent Act of 1952 is directed, see footnote 4 above.

LIBRARY
SUPREME COURT, U.S.

Office-Supreme Court, U.S.
FILED
JUN 20 1962
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM 1961

No. [redacted] 135

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,

Petitioner,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

FLOYD H. CREWS
Attorney for Respondent
405 Lexington Avenue
New York 17, New York

DARBY & DARBY
Donald J. Overocker
Gordon D. Coplein
405 Lexington Avenue
New York 17, New York
Of Counsel

June 22, 1962

LAWYERS PRESS, INC., 214 William St., N. Y. C. 38; Phone: BEekman 3-2300

INDEX

PAGE

Opinions in This Case 1

Additional Questions Presented 2

Counter Statement of the Case 3

Argument 9

The Question Presented by Pierce 9

The Questions Presented by Du Mont Above 11

Conclusion 12

TABLE OF CASES

Previous *Pierce* cases involving patent in suit 5

United States v. *American Bell Telephone Co.*, 167 U. S. 224, 247 (1896) 10

Leeds & Catlin Company v. *Victor Talking Machine Company*, 213 U. S. 301, 319 (1909) 10

IN THE

Supreme Court of the United States

OCTOBER TERM 1961

No. 993

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,

Petitioner,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION

Opinions in This Case

1. The opinion of the District Court granting the motion to substitute the Executrix, the widow of the original plaintiff, is reported at 154 F. Supp. 368 (D. Del., June 21, 1957, Judge Layton).

2. The opinion of the District Court denying Respondent's (Du Mont's) motion for summary judgment of invalidity of the six patents originally in suit, including patent 2,133,642 ('642), is reported at 166 F. Supp. 332 (D. Del., Sept. 12, 1958, Judge Layton).

3. The opinion of the District Court holding all five patents then in suit, including certain claims of the '642

patent, invalid for double patenting, after a full trial on the merits, is reported at 178 F. Supp. 84 (D. Del., Sept. 15, 1959, Judge Layton).

4. Du Mont's petition for certiorari (October Term, 1960, No. 611) on the question of survival was denied by this Court at 365 U. S. 816 (Feb. 20, 1961).

5. The opinion of the Court of Appeals affirming the District Court is reported at 297 F. 2d 323 (3d Cir., Nov. 29, 1961).

Additional Questions Presented

In the event certiorari is granted in this case the following additional questions should be considered:

1. Did the District Court have jurisdiction of the case—that is, does a cause of action for past patent infringement survive the death of the patent owner?

2. Is the patent in suit invalid over the prior art?

3. Is the patent in suit invalid because the claims are vague, indefinite and functional?

4. Are claims 64, 65 and 66 of the patent in suit invalid because there is no disclosure to support them?

5. Has the patent in suit been infringed?

6. Is the patent in suit unenforceable because it has been misused?

Counter Statement of the Case

1. Pierce's statement is badly garbled, incomplete, in part misleading, and in part factually erroneous.

2. On July 19, 1954 George Washington Pierce, the original plaintiff, sued Du Mont for infringement of six patents including the single surviving patent No. 2,133,642 (not 2,113,642). That patent (herein called '642) issued on October 18, 1938 and therefore expired on October 18, 1955 (2b).*

3. After its expiration George Washington Pierce died on August 25, 1956 (1a).*

4. A motion to substitute his Executrix (his widow) was opposed by Du Mont but was granted by Judge Layton in Opinion No. 1 above, which is reported at 154 F. Supp. 368 (D. Del., June 21, 1957). The opposition was on the ground that a cause of action for past infringement of a patent does not survive the death of the patentee.

5. A full trial of the action was held before Judge Layton beginning on March 24, 1959. At the trial Du Mont made a motion to dismiss on the ground of non-survival of the cause of action. The motion was denied.

6. Judge Layton, after a complete trial and full briefs, held all claims in suit, of all five patents, invalid. This included one group of claims of the '642 patent which he held

---

* Du Mont's Appendix in the Court of Appeals (a separate document) has page numbers followed by the suffix "b". Pierce's appendix was bound with her brief and has page numbers followed by "a".

invalid for double patenting over the earlier Pierce patent 1,789,496 (herein '496), which issued on Jan. 20, 1931 (24b).

7. Judge Layton did not pass on the question of whether that group of claims was (1) invalid over the prior art; or (2) whether those claims were invalid because vague, indefinite and functional; or (3) whether claims 64, 65, and 66 were also invalid because there is no disclosure to support them; or (4) whether any claim had been infringed; or (5) whether the patent was unenforceable because it had been misused.

8. On the appeal Pierce dropped all patents except '642, and restricted the appeal to claims 3, 24, 40, 51, 52, 54-56 and 61-68 of the '642 patent. All of these claims were in the group that had been held by Judge Layton to be invalid for double patenting over the '496 patent.

9. The Court of Appeals held that a cause of action for patent infringement does survive the death of a patent owner. It also held all appealed claims to be invalid for double patenting over the '496 patent, without passing on any of the defenses raised in questions 2 to 6 above.

10. On page 4 of the Petition, Pierce says:

> "The three Courts of Appeals for the First, Third and Fifth Circuits are agreed that this Pierce oscillator constituted a patentable invention."

11. The First and Third Circuit Courts of Appeals have held the '642 patent invalid for double patenting over the '496 patent. The Fifth Circuit Court of Appeals has not decided the merits of the patent. Any statement that Pierce chooses to interpret as any such "agreement" is dictum.

12. The '642 patent has been held invalid in the following actions:

Case 1: *American Communications Co. Inc.* v. *Pierce*, 208 F. 2d 763 (1st Cir. 1953); cert. denied 347 U. S. 944 (1954); rehearing denied 347 U. S. 970 (1954); reversing *Pierce* v. *American Communications Co., Inc.*, 111 F. Supp. 181 (D. Mass. 1953, Judge Ford).

Case 2: *Pierce* v. *Hewlett-Packard Co.*, 125 F. Supp. 329 (D. Mass. 1954, Judge Wyzanski); affirmed 220 F. 2d 531 (1st Cir. 1955); cert. denied 350 U. S. 833 (1955); rehearing denied 350 U. S. 897 (1955).

Case 3: *Pierce* v. *American Communications Co. Inc.*, and *Pierce* v. *Mackay Radio & Telegraph Inc.*, 159 F. Supp. 943 (D. Mass. 1958, Judge Ford), affirmed 280 F. 2d 278 (1st Cir. 1960); cert. denied 364 U. S. 902 (1960).

Case 4: *Pierce* v. *Aeronautical Communications Equipment, Inc.*, Order of Judge Choate granting summary (and final) judgment (S. D. Florida, Miami Division No. 5638-M Civil, 1957); case reversed and remanded for further proceedings, without passing on the merits. 255 F. 2d 458 (5th Cir. 1958). Second decision 198 F. Supp. 269 (S. D. Fla., 1961, Judge Gourley).

13. In these cases, referred to below by case number as listed above, the following claims of the '642 patent were held invalid for double patenting over the earlier '496 patent.

Case 1: Claims 51, 52, 54, 55, 56 and 61-68, inclusive.

Case 2: Claims 51, 52, 54-56 and 61-68 inclusive.

Case 3: All of the claims of the patent except claims 105 and 106 which were held invalid as being vague and there being insufficient disclosure in the patent to support them.

Case 4. All of the claims of the patent in the first decision.

(This was in the District Court. The Court of Appeals did not pass on the question of validity.)

Claims 51, 52, 54, 55 and 61-68 in the second District Court decision.

14. All of these decisions in Cases 1 to 4 above, were on motions for summary judgment or appeals therefrom. In Cases 1 to 3 this Court has denied certiorari on the question here presented.

15. On page 4 of the Petition, Pierce says:

"Each of the said Courts of Appeals further agrees that at one time Dr. Pierce tried to issue his Pierce oscillator element claims in the same patent as the co-operative transmitter-and-receiver combination claims, but that the Patent Office refused to permit this to be done."

16. This statement is wrong as to the Third Circuit Court of Appeals. All of the other cases were decided on motions for summary judgment and Pierce falsely represented this to be a fact before all of those Courts. Judge Layton made a similar statement in his Opinion (No. 2 above) in this case on Du Mont's motion for summary judgment, 166 F. Supp. 332 (D. Del. 1958), based on Pierce's misrepresentation to him that this was a fact.

17. In the present case the facts were fully presented at the trial, and both Judge Layton and the Court of

Appeals expressly held to the contrary. Judge Layton said in a footnote on 7a:

> "I have carefully reviewed the evidence on this point and conclude that there was no formal demand, or requirement, for a division."

and on page 15a:

> "* * * it is reasonably clear that no official action was entered by the Patent Office requiring a division;"

and again on page 29a:

> "Rines, seeing that he would either have to divide or suffer a final rejection by the Examiner and appeal therefrom, voluntarily divided."

18. The Court of Appeals in the present case adopted and quoted from Judge Layton's findings just quoted. (See footnote at page 22 of the Petition.)

19. The application for the '642 patent was first allowed with broad claims on Sept. 3, 1929, more than a year before the '496 patent issued on Jan. 20, 1931. The Court of Appeals said at Petition, page 22:

> "But this is not the present case. Here, the inventor, by merely paying his final fee could have obtained his generic patent more than a year before he actually obtained the narrower patent '496. He made a considered election to postpone his acquisition of the broader monopoly until he was sure that its exploitation would not be hampered by conflicting claims of a rival inventor."

and again on the same page:

> "This, therefore, is not a case where administrative action prevented the inventor from having his more

comprehensive application patented first, but rather where the choice has been the inventor's, dictated by his own judgment of possible economic advantage."

20. Pierce says on page 4 of the Petition:

"Each of said Courts of Appeals additionally agrees that the Patent Examiner requested Dr. Pierce's attorney to file a separate divisional application for the cooperative transmitter-and-receiver combination."

21. There is no support for this statement. The Patent Office never "requests" anybody to file a patent application and has no authority to do so.

22. On page 6 of the Petition, Pierce says:

"The Court of Appeals for the Fifth Circuit disagreed with the Court of Appeals for the First Circuit, 255 F. 2d 458 (Appendix B, pp. 34, 35)

'plaintiff did make a significant contribution with the Pierce oscillator, he is entitled to the patent on it *alone* to prevent its use without his consent *in any combination* and for the full 17 years.' (emphasis added)"

23. What the Court of Appeals for the Fifth Circuit held was that the District Court had not given the case adequate consideration in deciding it on the motion for summary judgment, and sent it back for further proceedings not inconsistent with its opinion. The sentence quoted in part from Appendix B, pp. 34, 35, actually appears on page 35 and begins with these words: "If, as appears to be undisputed, the * * *". On remand the District Court in its second decision (Case 4 above) held all claims then in suit of the '642 patent invalid for double patenting over

'496 (198 F. Supp. 269). This second decision is not mentioned in the Petition.

24. At the bottom of page 6 Pierce gives a partial quotation from Judge Layton's Opinion (No. 2 above) on Du Mont's motion for summary judgment in this case at 166 F. Supp. 332 (1958). The full quotation at 166 F. Supp. 335 is as follows:

> "In the face of the contrary results arrived at by the First and Fifth Circuit Courts, should defendant's motion be granted?
>
> "[1] I am impressed by the fact that it is strongly probable that Prof. Pierce has made a significant contribution with the Pierce oscillator. If this be so, he is entitled to a patent on it carrying with it all the protection to which an inventor is entitled for the full seventeen years of the life of the patent. It was not his fault that he was required to split his original application into several parts."

25. It will be noted that Pierce omitted the words "it is strongly probable" and "If this be so". She also omitted the entire last sentence which says that Judge Layton based his decision in part on the misrepresentation that had been made to him as to a Patent Office requirement for division.

Argument

The Question Presented by Pierce

Pierce asserts (Petition, p. 2) that the decision below "constitutes brand new law as to which no authority is even cited, and which is diametrically opposite to all prior decisions of the Supreme Court."

This is incorrect. The Court below cited earlier decisions of the Supreme Court (Petition, pp. 18-19), of the First

(Petition, p. 21), Seventh, D. C., and Sixth Circuit Courts of Appeals, the Court of Customs and Patent Appeals, and the Patent Office (Petition, p. 19), in support of its decision. There is no conflict with this or any other Court.

Pierce asserts conflict with the Fifth Circuit Court of Appeals decision in Case 4 above (pp. 5-6). As stated above, that Court of Appeals did not pass on validity. On remand the District Court again held the claims in suit of the '642 patent invalid for double patenting over the '496 patent. This decision on remand, not mentioned in the Petition, shows there is no conflict between the Third and Fifth Circuits.

Pierce asserts that the decision below creates confusion as to the status of combination and element patents. We know of no such confusion, and the authority cited by the Court below shows that there is no such confusion. Pierce gives no examples of confusion, and cites no cases showing any confusion.

The only cases cited by Pierce are *United States* v. *American Bell Telephone Co.*, 167 U. S. 224, 247 (1896) and *Leeds & Catlin Company* v. *Victor Talking Machine Company*, 213 U. S. 301, 319 (1909).

The *Telephone* case has nothing to do with the question. All the Court said there was that Congress could have fixed a different period for the life of a patent. No question of double patenting was involved.

The *Leeds & Catlin* case is equally pointless. There was no double patenting question in the case.

The Questions Presented by Du Mont Above

If certiorari should be granted, Question No. 1 presented above by Du Mont should be answered first as it goes to jurisdiction. This question was separately briefed and argued below in advance of the argument on the merits, but decision was withheld until after final argument. Before the argument on the merits the question was presented to the Supreme Court in a petition for writ of certiorari filed by Du Mont, in the October Term 1960, No. 611. At that time certiorari was denied, 365 U. S. 816 (1961).

The other questions presented above should either be decided by the Supreme Court or sent back for decision by the lower courts in the event the Court below should be sustained as to jurisdiction (survival) and reversed as to double patenting. These questions were all presented to both Courts below, who found it unnecessary to decide them in view of the other grounds for decision in Du Mont's favor.

CONCLUSION

It is accordingly prayed:

1. That the Petition be denied.

2. That if the Petition be granted Du Mont's Question No. 1 be decided first as a preliminary question.

3. That if the petition should be granted and Du Mont's Question No. 1 be answered in the affirmative and Pierce's question in the negative, then Du Mont's Questions Nos. 2 to 6 be decided by this Court, or the case remanded with instructions that they be decided by the Courts below.

Respectfully submitted,

FLOYD H. CREWS
Attorney for Respondent
405 Lexington Avenue
New York 17, New York

DARBY & DARBY
Donald J. Overocker
Gordon D. Coplein
405 Lexington Avenue
New York 17, New York
Of Counsel

June 22 1962

LIBRARY
SUPREME COURT U.S.

Office-Supreme Court, U.S.
FILED
JUN 23 1962
JOHN F. DAVIS, CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1962

No. ~~893~~ 138

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
PETITIONER,

v.

ALLEN B. DUMONT LABORATORIES, INC.,
RESPONDENT.

PETITIONER'S REPLY BRIEF

ROBERT H. RINES
DAVID RINES
No. Ten Post Office Square
Boston 9, Massachusetts
THOMAS COOCH
120 Montvale Road
Weston 93, Massachusetts
Attorneys for the Petitioner

Blanchard Printing Company, Boston, Mass. — Law Printers

In the
Supreme Court of the United States

OCTOBER TERM, 1961

No. 993

HELEN RUSSELL PIERCE, Executrix of the
Last Will and Testament of
GEORGE WASHINGTON PIERCE, Deceased,
PETITIONER,

v.

ALLEN B. DUMONT LABORATORIES, INC.,
RESPONDENT.

PETITIONER'S REPLY BRIEF

The petitioner has asked this Court to decide what the Court of Appeals for the Third Circuit has described (see top of page 9 of the Petition) as "difficult and doubtful points of law".

Three different Courts of Appeals have decided these points of law in four different ways, one of the Courts of Appeals changing its view with respect to those points of law upon a subsequent occasion (p. 6 of petition). Another of those Courts of Appeals has been asked to review its decision (p. 3 of petition) and argument thereon will take place next Tuesday, June 26.[1]

Not only have the three different Courts of Appeals dis-

[1] In its counter statement (certain erroneous parts of which are evident by reference to the actual, *not* respondent's paraphrased or out-of-context extracts from, holdings of the Courts of Appeals), respondent really admits the conflict of the circuits set forth in the petition.

agreed among themselves, but also the District Courts have done the same. One District Court, on two occasions, has arrived at directly contrary results, following one Court of Appeals in the one instance and another Court of Appeals in the second instance (bottom p. 6, top p. 7 of petition).

Not only that, but the decisions of the District Courts have not been approved by their own Courts of Appeals. (p. 5-7 of petition).

The Court of Appeals for the Third Circuit, indeed, in the case here-involved, has, contrary to respondent's erroneous assertion in counter statements #9 and 11, *positively refused* to follow its District Court's holding that the *element* patent is "double patenting" over the *combination* patent, because of the Supreme Court's recent decision in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 1961, 365 U.S. 336 to the effect that a combination claim does *not* protect only an element.

> Were this point essential to our decision it would be necessary to decide whether this view can be squared with recent decisions of the Supreme Court limiting the protection which a patent claiming only a particular combination can give to a constituent element of that combination. (citing the *Aro Mfg. Co.* case, *supra*, and other cases).

Instead, the Court of Appeals for the Third Circuit evolved the *brand new* doctrine of law set forth in the question on page 3 and the quotation on page 7 of the petition; namely, a highly original doctrine of illegal "extension of monopoly":[2]

[2] The so-called illegal extension of monopoly would appear to apply, if at all, whether or not the Patent Office requirement for division (counter statements # 17-19) was "formal" or informal, since the Patent Office obviously could not sanction any *illegal* extension. See footnote 4 of petition.

> We decide merely that patent '496 protected Pierce in the use of the Pierce oscillator in radio transmitting and receiving systems. We have already pointed out that it is the *extension of this monopoly* beyond its proper seventeen year term which invalidates the generic patent. (Emphasis added)

No citations are then given for support of this holding!

While asserting on pages 9 and 10 of its reply, that citations of the Supreme Court and other courts were presented in the decision of the Court of Appeals for the Third Circuit, respondent has failed to call attention to a *single cited decision* as to this doctrine of illegal "extension of monopoly."

Respondent, also on page 10, claims that it knows of no confusion as to the status of combination and element patents; and yet it does *not* refute a single one of the following assertions in the petition that show this:

> Every week the Patent Office is granting hundreds of patents for new combinations of elements as well as for new elements alone, and in no particular order of issuance.
>
> There are in force well over a half a million patents for new combinations of elements, as well as for new elements by themselves, already granted without regard to order of issuance.
>
> The status of all related combination and element patents, previously granted and presently being granted each week *without regard to their order of issuance*, has been thrown into serious doubt.
>
> Who now knows what is and is not an improper extension of a patent?

> Who now knows whether the order in which related combination and element patents issue is or is not of any significance, and thus whether present Patent Office practice is *spawning myriads of invalid patents every week?*

The Supreme Court, it is believed, should resolve this hopeless conflict which the Court of Appeals for the Third Circuit agrees, as before stated, involves

"*difficult* and *doubtful* points of law".

Respectfully submitted,

ROBERT H. RINES
DAVID RINES
No. Ten Post Office Square
Boston 9, Massachusetts
THOMAS COOCH
120 Montvale Road
Weston 93, Massachusetts
Attorneys for the Petitioner

LIBRARY
COURT, U.S.

Office-Supreme Court, U.S.
FILED
SEP 18 1962
JOHN F. DAVIS, CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1961.

No. [redacted] 138

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Petitioner,

vs.

ALLEN B. DUMONT LABORATORIES, INC.,
Respondent.

PETITIONER'S SUPPLEMENTAL BRIEF

ROBERT H. RINES,
DAVID RINES,
No. Ten Post Office Square,
Boston 9, Massachusetts,
THOMAS COOCH,
120 Montvale Road,
Weston 93, Massachusetts,
Attorneys for the Petitioner.

E. L. MERRENHALL, INC., 1108 Oak Street, Kansas City 6, Mo. HARRISON 1-3030

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1961.

No. 993

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Petitioner,

vs.

ALLEN B. DUMONT LABORATORIES, INC.,
Respondent.

PETITIONER'S SUPPLEMENTAL BRIEF

The awaited final decision of the Court of Appeals for the Fifth Circuit[1] has just been rendered (App. C hereof), finding the Pierce patent 2,133,642 "*valid*". ..

A *direct conflict* with the Court of Appeals for the Third Circuit thus exists, and undoubtedly the defendant in the Fifth Circuit litigation will soon file its petition for certiorari in this Court.

1. Discussed on page 3 of the Petition in this cause, and on page 1 of Petitioner's Reply Brief.

INDEX

Petitioner's Supplemental Brief 1

Appendix C, Opinion of the United States Court of Appeals for the Fifth Circuit 1A

Table of Cases

Aro Manufacturing Co. v. *Convertible Top Company*, 365 U.S. 336, 344 2

Electric Cable Co. v. *Edison Co.*, 292 U.S. 69, 70 2

Sola Electric Company v. *Jefferson Electric Company*, 317 U.S. 173, 174-175 2

To petitioner's knowledge, the Supreme Court has *always*[2] considered the granting of certiorari to be essential in cases where a patent has specifically been held valid in one circuit and invalid in another, since this raises an intolerable conflict of law.

This, of course, is altogether apart from the importance of resolving what the Court of Appeals for the Third Circuit described as "difficult and doubtful points of law" with regard to "illegal" extension of so-called monopoly, and apparently contrary interpretations by the Courts of Appeals for the Third and Fifth Circuits of the effect of the Supreme Court's recent decision in *Aro Manufacturing Co., v. Convertible Top Company*, 365 U.S. 336, 344.

Granting of the petition thus appears to be in order.

Respectfully submitted,

ROBERT H. RINES,
DAVID RINES,
No. Ten Post Office Square,
Boston 9, Massachusetts,
THOMAS COOCH,
120 Montvale Road,
Weston 93, Massachusetts,
Attorneys for the Petitioner.

---

2. See, for example, *Electric Cable Co.* v. *Edison Co.*, 292 U.S. 69, 70; *Sola Electric Company* v. *Jefferson Electric Company*, 317 U.S. 173, 174-175.

APPENDIX C

IN THE

United States Court of Appeals

FOR THE FIFTH CIRCUIT.

No. 19422

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,

Appellant,

versus

AERONAUTICAL COMMUNICATIONS EQUIPMENT INC.,

Appellee.

Appeal from the United States District Court for the Southern District of Florida.

(September 6, 1962)

Before TUTTLE, Chief Judge, BELL, Circuit Judge, and CARSWELL, District Judge.

TUTTLE, Chief Judge: We undertake here to present what we consider to be the fairly narrow issue that re-

mains to be decided in this extended and hard-fought litigation. We do this by assuming the correctness of all of the contentions of the appellee except the ultimate conclusion of law which remains for our decision. The issue can be posed as a question: If an inventor obtains a *combination* patent in the area of radio communication, which *combination* consists of a transmitting and receiving system, each of which, that is, both the transmitting part and the receiving part, includes an *element* known as an "oscillator," and the same inventor obtains a separate patent, applied for at the same time but issued some seven years later, on the oscillator itself, is the patent on the oscillator void for double patenting if it be assumed that its inclusion in each the transmitting and receiving parts of the combination patent was the essential element without which the combination patent would not have issued? In posing the question it must be made clear that in the *combination* patent no separate claim was made as such for the oscillator, each of the three claims of the patents being in terms "a transmitting and receiving system having, in combination, means for transmitting signal waves, means for receiving the signal waves, etc."

This Court has previously given consideration to the contentions now advanced by the parties when the case was here on an appeal from the grant by the trial court of a motion for summary judgment for the defendant, which was entered by it upon the "reasoning" of the Court of Appeals for the First Circuit in two earlier cases involving the same patents, *Pierce* v. *Aeronautical Communications Equipment Co.*, 5 Cir., 255 F.2d 458. We there held that, notwithstanding the decision of a court of a different circuit for which we have the highest respect, the inventor was entitled to have the validity of his patent passed on in a case against a different alleged infringer as to all factual

matters as well as on the legal issues involved by the courts of this circuit. We made reference to that earlier decision for a description of the patent now in suit, and a statement demonstrating its importance, or, at least, the importance of it, or the prior combination patent, in the art of radio communication. However, the following brief statement of facts is essential to an understanding of the question we have posed:

Professor Pierce, the appellant's decedent, was the unquestioned inventor of the Pierce oscillator which is claimed as the invention in the patent No. 2,133,642 here in issue. At the time of inventing the Pierce oscillator, Pierce invented a number of subsidiary electrical systems for which, by application of February 25, 1924, he endeavored to obtain a single patent covering them all. Since this application included not only general claims for the use of a piezoelectric crystal to control the frequency of an oscillating system (the oscillator) but also specific claims for the combination of a radio transmitter and receiver in which two of such crystals could be used, the Patent Office held[1] that more than one invention was described in the application and required a division. In compliance with this direction Pierce filed a number of additional applications

1. Much of the argument before this Court and before the other Courts in which this patent has been litigated, goes to the question whether Pierce's division of the several claims originally *filed into several different* applications, which resulted in several different patents, was actually required by a binding determination of the Patent Office. It is clear beyond dispute, however, that it was the Patent Office that made plain to Pierce that a patent would not issue covering all the claims which, if divided, might be the subject of separate patents. We think the record fully supports the statement made by this Court in the previous opinion to the effect that "it was the Patent Office that required the division that led to the two separate patents."

and two of the resulting patents are involved in this suit. One of the additional applications matured, however, on January 20, 1931, into patent No. 1,789,496, and this patent expired in 1948, before the defendant began the infringement acts complained of in this suit.

Patent No. 1,789,496, consisting of three claims, is for a radio transmitting and receiving system in combination, having a means of keeping the oscillations of both the transmitter and receiver at the same constant frequency. Claim 1 specifically mentions the use of a piezoelectric body for controlling the frequency of these oscillations and that would seem to allow the piezoelectric-crystal-controlled oscillators shown in the Cady patent No. 1,472,583 to be used as an element in the combined transmitting and receiving system. Claim 2 specifies the use of an electromechanical vibrator having two electric terminals in a single vacuum tube circuit, which circuit oscillates at a frequency widely independent of the other elements in the circuit. It thus apparently specifies the Pierce oscillator. Claim 3 is much broader in that it calls for any kind of prior art electro-mechanical vibrator to control the frequency.

Action on Pierce's other applications, which resulted from the division, was delayed because of requests for a fuller explanation of the properties of piezoelectric crystals and the failure to pay on time the required final fee. On April 20, 1930, the Patent Office issued a patent to John M. Miller covering claims 51, 52, 54, 55, 56 and 61 through 68 of Pierce's now patent No. 2,133,642. Litigation resulted in the holding that Pierce and not Miller was the inventor of the Pierce oscillator represented by the above claims. *Miller* v. *National Broadcasting Company, Inc.*, 3 Cir., 79 F.2d 657; *Miller* v. *Pierce*, 97 F.2d 141, 25 C.C.P.A., Patents, 1195. Thereafter, on October 18, 1938, the Pierce patents

No. 2,133,642 and No. 2,133,646 and the other patent still involved in this suit, were issued.

After the expiration in 1948 of the protection provided by patent No. 1,789,496 various business concerns began to produce electrical vibrator systems, which Pierce believed infringed his later patents, which had not, by that time, expired. He entered nine suits in several different circuits against various defendants. The principal contention as to infringement here relates to the thirteen claims, 51, 52, 54, 55 and 61 through 68 of No. 2,133,642. This is the patent covering the Pierce oscillator.

The parties do not contest the basic right of a patentee, in such circumstances, to have his claims passed on by the courts of the other circuits. In *Triplett* v. *Lowell*, 297 U.S. 638, the Supreme Court said at page 645:

> "The court whose jurisdiction is involved by such a suit [i. e., a second suit in a circuit other than the circuit which has already passed on the matter] must *determine for itself* validity and ownership of the claims asserted, notwithstanding a prior adjudication of invalidity of some of them, unless those issues have become res adjudicata by reason of the fact that both suits are between the same parties or their privies." (Emphasis added)

When the case was here before, we reversed the summary judgment entered by the trial court, because it was apparent that the trial court merely adopted the decisions of the Court of Appeals for the First Circuit in *American Communications Co.* v. *Pierce*, 1 Cir., 208 F.2d 763, and *Pierce* v. *Hewlett Packard Co.*, 1 Cir., 220 F.2d 531, without making its own decision, to which the patentee was entitled. In reversing the case, we stated that the language of the Court of Appeals for the First Circuit in the *Hewlett Packard* case "suggest that patent number 1,789,496 was

not valid at all in that it was issued for a combination radio transmitting and receiving system with claims both using and not using Pierce's oscillators." We then stated that if the '496 patent was not valid, then the defense of double patenting as to the '642 patent would be unavailing. However, the patentee's executrix, the appellant here, has now expressly waived any contention that the '496 patent was invalid. She, therefore, undertakes to meet the double patenting defense head-on.

As to the double patenting defense as applied in the First Circuit, we had the following to say:

> "Even if the First Circuit cases have analyzed the situation correctly, they do not proceed to the point of considering the position of a patentee who has a patent on a combination invention which includes in it a patentable element. The plaintiff in this case may be able to prove that the Pierce oscillator itself is not sufficiently described in claim 2 of patent No. 1,789,496 to provide Pierce with sufficient protection. If someone had used the Pierce oscillator in a system other than the radio system described in No. 1,789,496, the plaintiff would have had difficulties, perhaps insurmountable, in proving that he was afforded protection under No. 1,789,496. A *patent on a combination is a patent on the functioning whole, not on the separate parts* and the fact that an unpatented element of a combination may distinguish the invention does not draw to it the privileges of a patent. Mercoid Corporation v. Mid-Continent Investment Co., 320 U.S. 661, 64 S. Ct. 268, 88 L. Ed. 376; Mercoid Corporation v. Minneapolis-Honeywell Regulator Co., 320 U.S. 680, 64 S. Ct. 278, 88 L. Ed. 396; Rowell v. Lindsay, 113 U.S. 97, 5 S. Ct. 507, 28 L. Ed. 906. (Emphasis Added)

> "The reasoning of the above First Circuit opinions is, moreover, opposed to the basis of the division order and places the inventor in a perplexing dilemma. He

must divide his claims into separate applications for separate patents to comply with the Patent Office's requirements but when he does this he faces the prospect of losing part of his protection, if, as in this case, the patents are issued at different times, and the double patenting argument is used against him. If, as appears to be undisputed, the plaintiff did make a significant contribution with the Pierce oscillator, he is entitled to a patent on it alone to prevent its use without his consent in any combination and for the full 17 years. If the oscillator is not specifically claimed as such in patent No. 1,789,496 that patent should stand or fall as a combination patent and have no bearing on the oscillator patent No. 2,133,642; otherwise by obeying the Patent Office's order the plaintiff is denied a portion of the protection to which he is entitled.

"Since it was the Patent Office which required the division that led to the two separate patents, plaintiff does not come under the rule of Palmer Pneumatic Tire Co. v. Lozier, 6 Cir., 90 Fed. 732, prohibiting one from extracting an essential element of his invention from a former patent without which that patent would not have been granted and taking it for the subject of a new patent. Plaintiff originally had presented all of his claims in 1924 and because of the separation ruling and the litigation with Miller he was not awarded a final patent on the oscillator itself until 1938. He is not then in the position of one who tries to extend his coverage by taking the element from the combination for a later and separate patent. Plaintiff should now be allowed to prove that the oscillator is not specifically claimed in patent No. 1,789,496, and that at most it was only protected by that patent to the extent it was used in the combination described therein."

Upon remand the trial court seems to have been so preoccupied with the decisions of the Court of Appeals for the First Circuit, *supra*, and a subsequent one in the Third Circuit, *Pierce, Executrix,* v. *Allen B. DuMont Laboratories,*

Inc., 178 F. Supp. 84 (Dist. of Delaware), subsequently affirmed at 297 F.2d 323, that it paid little attention to the legal principles to be gleaned from our prior opinion. Thus it is that, without doing what we expressly stated the case was remanded for—to allow the plaintiff to "prove that the oscillator is not specifically claimed in patent No. 1,789,496," the Court posed an erroneous legal question. It said, "The question simply posed requires a determination as to whether patent No. 2,133,642 contains the same element as patent No. 1,789,496, and if this question is answered in the affirmative, the legal thesis of double patent would apply which would make patent 1,789,496 a predicate for the double patenting of No. 2,133,642." Even this question, it seems to us, does not accurately state what the trial court then proceeded to consider, because obviously the combination patent, 1,789,496, contained many elements in the transmitting and receiving system that were not "contained" in patent 2,133,642, which was purely and simply a patent on the oscillator. Perhaps the Court meant to state the question to be whether "Patent No. 2,133,642 comprises *any of the same elements* as patent No. 1,789,496, and if this question is answered in the affirmative, the legal thesis of double patenting would apply, etc." If this is the question the Court undertook to answer, then it clearly conflicts with the law as laid down by our prior opinion, for we stated, "a patent on a combination is a patent on the functioning whole, not on the separate parts and the fact that an unpatented element of a combination may distinguish the invention does not draw to it the privileges of a patent." Yet the trial court held that since the Pierce oscillator "distinguished the invention," to use our earlier language, or was the "essential element" of the combination patent, to use the language of the trial court, the patent on the oscillator must fail on the basis of double patenting.

Moreover it is clear that the trial court completely ignored that part of our earlier opinion quoted above dealing with the case of *Palmer Pneumatic Tire Co.* v. *Lozier*, 6 Cir., 90 Fed. 732, where we said that the plaintiff here "does *not* come under the rule of *Palmer Pneumatic Tire Co.* v. *Lozier*, 6 Cir., 90 Fed. 732, prohibiting one from extracting an essential element of his invention from a former patent, without which that patent would not have been granted, and taking it for the subject of a new patent." Ignoring this prior holding, the trial court said, "Pierce cannot extract this essential element and make it the basis of a subsequent patent, since the Pierce oscillator, the subject of patent No. 2,133,642, rather than the production of a constant beat, is the essential distinguishing feature of combination patent 1,789,496."

The Supreme Court has written fairly recently on the plain distinction between a combination patent and its elements. The latest word on this subject comes from *Aro Manufacturing Co. v. Convertible Top Company*, 365 U.S. 336, where, on page 344, the Court says:

> "For if anything is settled in the patent law, it is that the combination patent covers only the totality of the elements in the claim, and that no element, separately viewed, is within the grant," citing Mercoid Corp v. Mid-Continent Co., supra.

The Court then proceeds to say:

> "The basic fallacy in respondent's position is that it requires the ascribing to one element of the patented combination, the status of patented invention itself. Yet this Court has made it clear in the two Mercoid cases that there is no legally recognizable or protected 'essential' element, 'gist,' or 'heart' of the invention in a combination patent."

Referring to the *Mercoid* case, we find the following language:

> "* * * We now add that it makes no difference that the unpatented device is part of the patented whole.
>
> "That result may not be obviated in the present case by calling the combustion stoker switch the 'heart of the invention,' or 'the advance in the art.' The patent is for a combination only, since none of the separate elements of the combination is claimed as the invention, none of them, when dealt with separately, is protected by the patent monopoly."

So here, since the Pierce oscillator is not claimed as the invention, it is not "protected by the patent monopoly" in the combination patent. This being true, the patent subsequently issued on the oscillator cannot be held to be void for double patenting because it has never been patented before.

It is not contended by the appellee, here the alleged infringer, that the delay in the issuing of the 642 patent was accomplished in any manner that in and of itself subjected it to an attack on its validity. We have pointed out that it is also not seriously disputed that the division of the original patent into the several that subsequently gave rise to the charge of double patenting was upon the suggestion, if not the direction, of the Patent Office. To the extent then that the decisions of the other courts which have passed on this question are based on the idea that the patentee in some manner improperly or inequitably extended the period of his monopoly on the Pierce oscillator by causing it to be issued seven years later than the combination patent which embodied it as one of its elements, we find no authority for thus limiting the rights of a patentee. Either the '642 patent is valid, as clearly claiming a patentable in-

vention[2] or it was invalid because it was the subject of a prior patent, which, of course, would be patent '496. Since, however, as we have pointed out, the Supreme Court has repeatedly held that no separate *element* of a combination patent is given any monopoly under the patent laws, but only the *combination as a whole* is protected, there can be no double patenting where the patent issued subsequently constitutes one of the elements of the combination patent.

What we have heretofore said with respect to the thirteen claims to the '642 patent applies even more strongly with respect to the other of the two subsequent patents still at issue here, No. 2,133,646. As to these the trial court made no effort to analyze the respective claims, or to determine whether claims 5, 9, 16, 22 and 23 of '646 were covered by any of the three claims of 1,789,496. The court simply said, "No useful purpose could be served by setting forth in detail the nature and the basis of the patent which is being discussed since, in my judgment, the validity has been most learnedly and thoroughly considered by other courts whose conclusions I am impelled to follow. The invalidity of the patent on the thesis of double patenting is therefore adjudicated on the basis of the following authorities: 159 F. Supp. 943, Dist. of Mass., 280 F.2d, 1 Cir. 278, and 178 F.2d 84, Dist. of Delaware." Ignoring, therefore, the express mandate of this court on the subject matter, the trial judge denied the patentee the right which all parties have consistently agreed he has, that is to an independent consideration of the validity of the patent by the trial court in this circuit, *Triplett v. Lowell, supra,*

---

2. Every court that has passed on any of these patents has recognized that, standing alone, this '642 patent would be a valid patent because of the very substantial contribution made to the art by the Pierce oscillator.

and this it did notwithstanding the mandate of this court expressly directing it to consider the question whether the Pierce oscillator was specifically claimed in patent No. 1,789,496.

Having concluded that the trial court erred in holding that the thirteen claims of 2,133,642, and the five claims of 2,133,646 were void or invalid for double patenting, was error, we now decide that, the said defenses having failed, the said claims of the two patents are valid. The case is now remanded to the trial court for the purpose of determining whether the appellee infringed these two patents and for further proceedings not inconsistent with this opinion.

REVERSED and REMANDED.

LIBRARY
SUPREME COURT U.S.

Office-Supreme Court, U.S.
FILED
SEP 27 1962
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM 1961

No. [redacted] 138

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,

Petitioner,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Respondent.

RESPONDENT'S SUPPLEMENTAL BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

FLOYD H. CREWS
Attorney for Respondent
405 Lexington Avenue
New York 17, New York

DARBY & DARBY
Donald J. Overocker
Gordon D. Coplein
405 Lexington Avenue
New York 17, New York
Of Counsel

September 27, 1962

LAWYERS PRESS, INC., 95 Morton St., N. Y. C. 14. Phone: CHelsea 3-1220

In the

Supreme Court of the United States

October Term 1961

No. 993

Helen Russell Pierce, Executrix of the Last Will and Testament of George Washington Pierce, Deceased,

Petitioner,

—v.—

Allen B. Du Mont Laboratories, Inc.,

Respondent.

RESPONDENT'S SUPPLEMENTAL BRIEF IN OPPOSITION TO PETITION

This brief is in opposition to Petitioner's Supplemental Brief. We will show:

1. This Court has denied certiorari where there was a direct conflict between two Circuits as to validity, where the patent had already expired. The patent here expired 7 years ago.

2. That there is no actual conflict of law between the two Circuits, only a conflict of fact.

I.

Certiorari Should Be Denied Since the Patent Expired Seven Years Ago.

The only Pierce patent in question here was granted on October 18, 1938. Therefore, it expired 17 years later[1]

[1] 35 U. S. C. 154 (1958).

on October 18, 1955. This was some six years prior to the decision of the Third Circuit Court of Appeals[2] and some seven years prior to the alleged conflicting decision of the Fifth Circuit Court of Appeals.[3]

Petitioner says that she knows of no prior denial of certiorari where there was "conflict" between two Circuits on validity of a patent. Petitioner overlooked the case of *Frank B. Killiam & Co.* v. *Allied Latex Corp.* in which this Court denied certiorari despite such a conflict.

The facts of the *Killiam* case are strikingly similar to the facts here. There, the patent in question (1,605,445) was issued on November 2, 1926 and it expired on November 2, 1943. The patent was first held *valid* by the Court of Appeals for the Eighth Circuit[4] and later held *invalid* by the Court of Appeals for the Second Circuit[5] 8 years after it expired. Certiorari was denied.[6]

There would be nothing to be gained by the granting of this Petition since there is no public interest remaining to be served in view of the expiration of the patent. Further, there is no question involved which would have any bearing upon future decisions.

For these reasons alone, the Petition should be denied.

---

[2] *Pierce* v. *Allen B. Du Mont Laboratories, Inc.*, 297 F. 2d 323 (decided November 29, 1961).

[3] Decided on September 6, 1962. This decision is reprinted in Appendix C of Petitioner's Supplemental Brief.

[4] *Dean Rubber Manufacturing Co.* v. *Killiam*, 106 F. 2d 316 (8th Cir. 1939).

[5] *Frank B. Killiam & Co.* v. *Allied Latex Corp.*, 188 F. 2d 940 (2nd Cir. 1951).

[6] 342 U. S. 861 (1951); 96 L. ed. 648; 72 S. Ct. 86; rehearing denied 342 U. S. 895 (1951); 92 L. ed. 670.

II.

Certiorari Should Be Denied Since There Is No Actual Conflict of Law Between the Circuits—Only of Fact.

In Petitioner's Supplemental Brief, it is asserted that the Petition for Certiorari should now be granted in view of the "direct conflict" that exists between the decisions of the Court of Appeals for the Third Circuit (decided November 29, 1961)[7] and the Court of Appeals for the Fifth Circuit (decided September 6, 1962)[8] on the question of the invalidity for double patenting of Pierce patent 2,133,642 over prior issued Pierce patent 1,789,496. There is no conflict of law between the two Circuits, but only of fact of whether the Patent Office required division.

The holding of double patenting[9] by the Court of Appeals for the Third Circuit is based upon the law stated in *Palmer* v. *Lozier*, 90 Fed. 732 (6th Cir. 1898). The *Palmer* case, which follows *Miller* v. *Eagle Manufacturing Co.* (1894), 151 U. S. 186, 198, clearly holds that a patentee who has made only a single invention cannot extract the essential element which resulted in the granting of a first patent for a combination and make this essential element the subject of a separate and later issued patent. To do so would extend the monopoly of the single invention.

In reaching its holding of double patenting of Pierce patent 2,133,642, the Third Circuit Court of Appeals, and

---

[7] *Pierce* v. *Allen B. Du Mont Laboratories, Inc.*, 297 F. 2d 323 (3rd Cir. 1961); affirming 178 F. Supp. 84 (D. Del. 1959), which held Pierce patent 2,133,642 invalid for double patenting over prior issued Pierce patent 1,789,496.

[8] Reprinted in Appendix C of Petitioner's Supplemental Brief. (Citations to Appendix C are designated by p. A.)

[9] 297 F. 2d 323.

the District Court, were confronted with the previous Third Circuit decision in *National Tube Co.* v. *Steel & Tubes, Inc.*, 90 F. 2d 52 (3rd Cir. 1937), which held that where the Patent Office required division of one patent application into several applications, there could be no later holding of double patenting.

After a full trial on the merits, at which Petitioner's counsel (the same attorney who prosecuted the patents in question in the Patent Office) testified, the District Court for the District of Delaware expressly held[10] that there was no requirement for division by the Patent Office;[11] that *National Tube* v. *Steel & Tubes* therefore did not apply; that the doctrine of *Palmer* v. *Lozier* was applicable; and that Pierce patent 2,133,642 was invalid for the double patenting over prior issued Pierce patent 1,789,496. The Third Circuit Court of Appeals expressly affirmed each of these holdings of the District Court, including the holding that there was no requirement for division made by the Patent Office.

The "independent consideration" (p. 11A) and decision by the Fifth Circuit Court of Appeals, holding that there was no double patenting, stands upon an entirely different foundation. There was no contested trial in the District Court and no confrontation of witnesses by the Court.

However, the Court of Appeals for the Fifth Circuit said (p. 3A, footnote 1):

> "We think the record fully supports the statement made by this Court in the previous opinion to the effect

---

[10] 178 F. Supp. 84 (D. Del. 1959).

[11] 178 F. Supp. 85, footnote 3, at which the Court states: "I have carefully reviewed the evidence on this point and conclude that there was no formal demand, or requirement, for a division."

that 'it was the Patent Office that required the division that led to the two separate patents.'"

Therefore, after finding that there *was a Patent Office requirement for division*, the Court said (p. 7A) that:

"Since it was the Patent Office which required the division that led to the two separate patents, plaintiff does not come under the rule of Palmer Pneumatic Tire Co. v. Lozier, 6 Cir., 90 Fed. 732, prohibiting one from extracting an essential element of his invention from a former patent without which that patent would not have been granted and taking it for the subject of a new patent."

And again the Court said (p. 9A):

"Moreover, it is clear that the trial court completely ignored that part of our earlier opinion quoted above dealing with the case of Palmer Pneumatic Tire Co. v. Lozier . . ."

Therefore, it is clear that the Fifth Circuit decision does not repudiate *Palmer* v. *Lozier* as the law. Instead, the Court impliedly recognizes *Palmer* v. *Lozier* as still being the law but never reaches the application of its doctrine because of the Court's holding that the Patent Office required division, which resulted in the two patents. Therefore, had it not been for the erroneous finding by the Fifth Circuit Court of Appeals that there was a Patent Office requirement for division, that Court would have been constrained to hold double patenting on the basis of *Palmer* v. *Lozier*.

Petitioner is therefore asking this Court to review only a conflict of fact. It has been a long standing practice of this Court to deny certiorari to review evidence and discuss particular facts, *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175, 178 (1937), 82 L. Ed. 1273, and there is no reason for an exception in this case.

Finally, there is no "conflict" between the decision of the Court of Appeals for the Third Circuit in this case and the decision of this Court in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.* (1961), 365 U. S. 336. The *Aro* case concerned the question of contributory infringement, which is entirely separate and distinct from the question of double patenting and the extension of the duration of the patent monopoly presented here.

CONCLUSION

It is accordingly prayed:

1. That the Petition be denied.

2. That if the Petition be granted Du Mont's Question No. 1 be decided first as a preliminary question.

3. That if the Petition should be granted and Du Mont's Question No. 1 be answered in the affirmative and Pierce's

question in the negative, then Du Mont's Questions Nos. 2 to 6 be decided by this Court, or the case remanded with instructions that they be decided by the Courts below.

Respectfully submitted,

FLOYD H. CREWS
Attorney for Respondent
405 Lexington Avenue
New York 17, New York

DARBY & DARBY
Donald J. Overocker
Gordon D. Coplein
405 Lexington Avenue
New York 17, New York
Of Counsel

September 27, 1962

LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
OCT 5 1962
JOHN F. DAVIS, CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962.

No. 138.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Petitioner,

vs.

ALLEN B. DUMONT LABORATORIES, INC.,
Respondent.

PETITIONER'S REPLY TO RESPONDENT'S SUPPLEMENTAL BRIEF

ROBERT H. RINES,
DAVID RINES,
No. Ten Post Office Square,
Boston 9, Massachusetts,
THOMAS COOCH,
120 Montvale Road,
Weston 93, Massachusetts,
Attorneys for the Petitioner.

E. L. MERIDENHALL, INC., 1108 Oak Street, Kansas City 6, Mo., HArrison 1-3030

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962.

No. 138.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Petitioner,

vs.

ALLEN B. DUMONT LABORATORIES, INC.,
Respondent.

PETITIONER'S REPLY TO RESPONDENT'S SUPPLEMENTAL BRIEF

Petitioner shall treat with the two matters raised in Respondent's Supplemental Brief in Opposition to Petition, in inverse order.

The Conflict of Circuits As to the Validity of the Pierce Patent Is a Conflict on a Vital Point of Patent Law, and Not a Conflict of Fact

The incorrectness of respondent's attempt to twist the conflict of circuits into a mere conflict of "fact", as to whether or not the Patent Office ordered a division of

patent applications leading to the granting of two patents to Professor Pierce, is evident from the statement of the Court of Appeals for the Third Circuit *itself*, that, even on its fact finding, this is a

> "case involving difficult and doubtful points of *law*" (*not* fact), as to so-called illegal extension of monopoly.

The First Circuit, indeed (like the Fifth Circuit), found that the earlier Pierce patent

> "issued on an application filed . . . as a division *by Patent Office order.*" (*Pierce* v. *American Communications Company, Inc., et al.*, 280 F.2d 278, 280, 1 Cir., 1960).

Similarly, the courts of the Third Circuit found that the Patent Office had forced Professor Pierce to divide, holding only that there was no "formal" order for division, but that Professor Pierce saw

> "that he would either have to divide or suffer a final rejection by the Examiner". (*Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 297 F.2d 323, 328, 3 Cir., 1961, Appendix to Petition herein, p. 22).

There is thus no "fact" conflict of any consequence, as is also made plain in the latest decision, a few weeks ago, of the Court of Appeals for the Fifth Circuit:

> "It is clear beyond dispute, however, that it was the Patent Office that made plain to Pierce that a patent would not issue covering all the claims which, if divided, might be the subject of separate patents." (*Pierce* v. *Aeronautical Communications Equipment, Inc.*, September 6, 1962, Appendix to Petitioner's Supplemental Brief, p. 3A.)

The conflict of circuits as to the validity of the Pierce patent is thus clearly a *conflict of law*.

The Respondent Is in Error in Stating That the Supreme Court Has Refused Certiorari, Even After Patent Expiration, Where Two Circuits Have Disagreed on Valjdity

In petitioner's supplemental brief, she states that to her knowledge,

> "the Supreme Court has *always* considered the granting of certiorari to be essential in cases where a patent has specifically been held valid in one circuit and invalid in another, since this raises an intolerable conflict of law."

Respondent apparently agrees except for an alleged single instance, *Frank B. Killian & Co.* v. *Allied Latex Corp.*, 188 F.2d 940, 2 Cir., 1951, cert. den 342 U.S. 861, 895.

But respondent is entirely *incorrect* as to that single instance. In that case, to the contrary, Patent 1,605,445, held valid in *Dean Rubber Mfg. Co. et al.* v. *Killian*, 106 F.2d 316, 8 Cir., 1939, was also earlier held valid in the second circuit, *Stevens* v. *Carl Schmid, Inc.*, 73 F.2d 54, 2 Cir., 1934, and was merely held *not infringed* (but not *invalid*) in *Frank B. Killian & Co.* v. *Allied Latex Corp.*, 188 F.2d 940, 2 Cir., 1951:

> "decide this action upon the issue of non-infringement *without actually overruling any of the past decisions*" (p. 942).

It is because there was *no* conflict on *validity* that the Supreme Court doubtless denied certiorari.

The petitioner's statement that contrary holdings of validity have *always* been resolved by the Supreme Court thus stands.

Because of the long-term consequences of a six-year statute of limitations on infringement

> "A direct conflict of decisions between Courts of Appeals . . . as to *validity* . . . is a sufficient ground in itself for the granting of a petition for a writ of certiorari. . . . The moving consideration for the granting of the writ in these cases is the practical fact that a particular patent or claim thereof is valid in one circuit and invalid in another"[1];

certiorari having apparently always been granted under Rule 19(b) of this Court,[2] in the circumstances of the present case, *even after the patent in suit has expired.*[3]

The more so is certiorari in order in the present case in view of

(1) the conflict of the Third and Fifth Circuits as to the effect of this Court's recent holding on the scope of combination and element patents in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 1961, 365 U.S. 336, that a combination claim does *not* protect only an element (with which the Fifth Circuit agrees, but with which the Third Circuit, by the consequences of its decision, disagrees);

(2) the now unsettled status of well over a half a million patents for new combinations of elements, as well as for new elements by themselves, already granted, *as in Professor Pierce's case*, without regard to order of issuance; and

(3) the present practice of the Patent Office that, *if the Third Circuit decision is permitted to stand*, is currently spawning invalid patents every week in the *precise manner of Professor Pierce's case.*

---

1. Wolfson and Kurland, "Jurisdiction of the Supreme Court of the United States", 1951, Section 354, p. 705.

2. "Where a Court of Appeals has rendered a decision in conflict with the decision of another court of appeals on the *same* matter . . . ."

3. Wolfson and Kurland, *supra*, pp. 706, 707.

CONCLUSION

Settling of what the Third Circuit Court of Appeals itself admitted were such "difficult and doubtful points" of patent law, thus thrown into confusion by this conflict of decisions is believed to be as worthy of attention as at least some of the personal liberty causes so freely championed by this Court.

The *same Constitution* that protects the individual's personal liberties, guarantees the inventor, also, the protection of his discoveries (Article I, Section 8).

Respectfully submitted,

ROBERT H. RINES,
DAVID RINES,
No. Ten Post Office Square,
Boston 9, Massachusetts,
THOMAS COOCH,
120 Montvale Road,
Weston 93, Massachusetts,
Attorneys for the Petitioner.

Office-Supreme Court, U.S.
FILED
NOV 2 196
JOHN F. DAVIS, CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962

No. 138.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased.
Petitioner.

vs.

ALLEN B. DUMONT LABORATORIES, INC.,
Respondent.

PETITION FOR REHEARING.

ROBERT H. RINES,
DAVID RINES,
No. Ten Post Office Square,
Boston 9, Massachusetts,
THOMAS COOCH,
120 Montvale Road,
Weston 93, Massachusetts,
Attorneys for the Petitioner.

R. L. MERDENHALL, INC., 1108 Oak Street, Kansas City 6, Mo. HArrison 1-3030

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962.

No. 138.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Petitioner,

vs.

ALLEN B. DUMONT LABORATORIES, INC.,
Respondent.

PETITION FOR REHEARING.

Your petitioner respectfully prays that this Honorable Court rehear and reconsider the merits of the petition for a writ of certiorari in the above cause.

Subsequent to this Court's denial of the petition, a further petition has been filed by Aeronautical Communications Equipment, Inc., for review of a recent September 6, 1962, Fifth Circuit decision in direct conflict with the Third

Circuit decision in the present cause as to precisely the same Pierce patent.[1]

There can *never be* a more clashing conflict of circuits than in this present case.

It will be recalled[2] that the Court of Appeals for the First Circuit had ruled that the Pierce patent was invalid for double patenting, but that the Court of Appeals for the Fifth Circuit

> "notwithstanding a decision of a court of a different circuit for which we have the highest respect",

disagreed with this holding and held that there was no double patenting. Thereafter, the Court of Appeals for the First Circuit, despite this holding by the Court of Appeals for the Fifth Circuit, adhered to its view that there was double patenting.

In the meantime, the Court of Appeals for the Third Circuit, in the light of the decisions of both the Court of Appeals for the First Circuit and the Court of Appeals for the Fifth Circuit, disagreed with both Courts of Appeals.

It refused to hold double patenting and it refused to hold that there was not double patenting, but held the Pierce patent invalid upon a new theory of *illegal extension of monopoly.*

---

1. Petition No. 558, filed October 24, 1962, *Aeronautical Communications Equipment, Inc.*, v. *Helen Russell Pierce, Executrix*, No. 19422, U.S. Court of Appeals for the Fifth Circuit, decided September 6, 1962 (See Appendix A, or Appendix C of your present Petitioner's Supplemental Brief which, like Petitioner's Reply to Respondent's Supplemental Brief, was probably called to the attention of this Court after the decision not to grant the writ).

2. Petition, pp. 5-7.

Since the petition in this case was filed, the Court of Appeals for the Fifth Circuit was afforded an opportunity to reconsider its earlier decision in the light of the latest decisions of the Courts of Appeals for the First and Third Circuits. The Court of Appeals for the Fifth Circuit insisted, however (September 6, 1962), that there was no double patenting or illegal extension of monopoly.

In the October 24, 1962, petition for certiorari No. 558,[3] filed to review the September 6, 1962, decision of the Court of Appeals for the Fifth Circuit, the petitioner complains that the Pierce patent is now valid in one part of the United States and invalid in other parts. Your petitioner agrees. It is submitted that this Court should resolve this conflict since there is no other way in which that conflict can be resolved.

There are moreover, a number of civil actions still pending in various District Courts the prosecution of which has been held up pending a final decision as to whether the basic Pierce oscillator patent 2,133,642 is or is not valid or enforceable.

Your petitioner will be helpless to prosecute these civil actions and the various District Courts will be equally helpless unless guidance is obtained from the Supreme Court. It would save endless work for the District Courts, let alone the litigants, if they would be informed, by this Court, which of the four conflicting decisions of the three Courts of Appeals is correct.

There can *never* be a more far-reaching issue of patent law before this Court than the resolution of this "difficult

---

3. Your petitioner is filing a detailed reply brief in the Fifth Circuit petition No. 558.

and doubtful"[4] ruling of so-called *unlawful extension of monopoly*; since the Patent Office, each week, is continuing to issue patents for elements and combinations of elements in *precisely the same order as Professor Pierce's patents*, and is thus spawning myriads of invalid patents, if the Third Circuit decision is permitted to stand!

In the words of the petitioner in the Fifth Circuit Aeronautical Communications Equipment, Inc.,

> The public, the courts and the Patent Office should be informed by this Court. . . .

thus removing

> This uncertainty . . . and . . . doubt as to the rights of the public under the Patent Laws . . .

A PLEA TO THE JUSTICES.

Out of about *1300* written decisions of this Court since the passage of the Patent Act of 1952, only *1* appears to bear upon the law of patents.

Your petitioner respectfully calls the attention of this Court to the fact that proprietary rights as well as personal liberties are deserving of the time of this Court.

It is, indeed, the *same Constitution* that protects the individual's personal liberties, that was intended to guarantee inventors, such as world-renowned Professor Pierce, the protection of their property rights in discoveries.

It is inconceivable that a more direct or confusing conflict of circuits or a more far-reaching issue of patent law

---

4. The words of the Third Circuit Court of Appeals itself!

can possibly be submitted to this Court, so that reconsideration and granting of the writ appears in order.

Respectfully submitted,

ROBERT H. RINES,
DAVID RINES,
No. Ten Post Office Square,
Boston 9, Massachusetts,
THOMAS COOCH,
120 Montvale Road,
Weston 93, Massachusetts,
Attorneys for the Petitioner.

CERTIFICATE OF COUNSEL.

It is hereby certified that the above petition for rehearing is presented in good faith and not for delay and that it is restricted to the grounds specified in Rule 58 (2) of this Court.

ROBERT H. RINES.